Supreme Court, U.S.
FILED
JUL 31 2007
OFFICE OF THE CLERK

No. 07- 07-150

IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED AND AVENT AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

PETITION FOR A WRIT OF CERTIORARI

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QUESTIONS PRESENTED

Whether the Federal Circuit has erred in holding that prosecution disclaimer can be used to read a limitation back into an issued patent claim, after removal of that limitation during prosecution to broaden the claim away from it.

Whether the Federal Circuit has erred in holding that claim construction and patent validity rulings can be entered without reliance on the evidentiary underpinnings required by this Court's precedent.

CORPORATE DISCLOSURE STATEMENT

Petitioner Nouri E. Hakim is a private individual and part owner of Luv n' care Ltd. Luv n' care, Ltd. has no parent corporation and no publicly held company owns 10% or more of its stock.

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OPINIONS BELOW

The opinion of the Court of Appeals is reported at 479 F.3d 1313 and is set forth in the Appendix ("App.") at App. 1a-15a. The order denying the petition for rehearing was reported at 2007 U.S. App. LEXIS 11682 (App. 49a-50a). The judgment of the United States District Court for the Western District of Louisiana regarding the '931 patent is reported at 2005 U.S. Dist. LEXIS 16830 (App. 18a-19a); its judgment regarding the '620 patent is are reported at 2005 U.S. Dist. LEXIS 16831 (App. 16a-17a); and its judgment regarding Hakim's expert declaration are reported at 2005 U.S. Dist. LEXIS 16829 (App. 65a-67a). The Magistrate's Report and Recommendation regarding the '931 patent is reported at 2005 U.S. Dist. LEXIS 16827 (App. 33a-48a); his Report and Recommendation regarding the '620 patent is reported at 2005 U.S. Dist. LEXIS 16833 (App. 20a - 32a); and his Order regarding the Hakim Declaration is reported at 2005 U.S. Dist. LEXIS 16828 (App. 68a-69a).

JURISDICTION

The judgment of the Court of Appeals was entered on February 23, 2007. A petition for rehearing was filed and denied on May 2, 2007. This Court's jurisdiction is invoked under 28 U.S.C. § 1254(1).

The District Court had jurisdiction to hear Petitioner's claim for patent infringement under 28 U.S.C. § 1338(a). The Federal Circuit had jurisdiction to hear Petitioner's appeal under 28 U.S.C. § 1295(a)(1).

CONSTITUTIONAL PROVISION INVOLVED

Article I, section 8, clause 8 of the Constitution provides:

> "Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their Respective Writings and Discoveries."

REGULATORY PROVISIONS

Section § 1.75 of the Code of Federal Regulations provides:

> More than one claim may be presented provided they differ substantially from each other . . . 37 C.F.R. § 1.75(b).

> The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description. 37 C.F.R. § 1.75(d)(1).

STATEMENT OF THE CASE

This case raises questions of significant importance to patent claim construction, namely, the factual and legal methodology that must be followed to assess the meanings of claim terms, which affects all issues of patent infringement and validity.

Throughout its history, this Court has repeatedly set forth the evidentiary requirements pertinent to construing patent claim terminology. In *Markman,* this Court acknowledged that the process of claim construction has various evidentiary underpinnings associated with it. *Markman v. Westview Instruments, Inc.,* 517 U.S. 370 (1996). Further thereto, it assigned the judge the role of construing patent terms in a manner that fully comports with the specification and claims and preserves the patent's i ternal coherence. *Markman,* 517 U.S. at 390. Subsequent to *Markman,* however, the Court of Appeals' treatment of the various evidentiary requirements, and its approaches to claim construction, have been widely recognized to have promoted no predictability or uniformity.

Furthermore, as shown here, it can produce entirely illogical and unjust results. In this case, the district court refused to hold a Markman hearing and took no testimony from anyone skilled in the art as part of its construction of the claims. Rather, it chose to enter claim construction and validity rulings without reliance on any evidence regarding the meaning of disputed terms to those of engineering skill in the field of the invention. On appeal, the Federal Circuit affirmed the district court's findings, even though the fundamental evidentiary requirements mandated by this Court's precedent were simply not present. It held that claim construction and fact finding regarding the disputed terms may "not be necessary", though the parties below disputed the terms' construction and the legal issue of anticipation on summary judgment turned on the disputed construction. As a result, the Court of Appeals upheld thoroughly illogical claim construction rulings that "invert" is the same as "lift", and that a hole is not an opening.

Furthermore, the Court set forth a new rule of prosecution disclaimer under which applicants who amend a claim for the purposes of broadening it can still have their claims

limited to the prior, narrower, version of the claim that was abandoned. The court ruled that the narrower limitation continues to control unless the prosecution history is also amended to 'rescind' the prior remarks about it, even if the limitation itself was expressly deleted from the claim.

This is expressly contrary to this Court's precedent that the words of the claims and specification themselves control, and is contrary to the principles applied by the Patent Office during prosecution. Furthermore, since patents are frequently amended during prosecution to broaden their claims – particularly in continuation applications – the decision drastically undermines the value of large numbers of patents issued before pronouncement of this newest precedent.

2. It has been a fundamental patent principle for well over one hundred years that the words in the claims are critical to determining a patent's scope.[1] The evidentiary findings necessary to construe those claims have been set forth by this Court on numerous occasions. For one, the plain meaning of the claim language is highly important. Because the patentee is required to "define precisely what his

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1. *Merrill v. Yeomans*, 94 U.S. 568, 570 (1876) (the claim is "of primary importance, in the effort to ascertain precisely what it is that is patented."); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961) ("the claims made in the patent are the sole measure of the grant"); *White v. Dunbar*, 119 U.S. 47, 52 (1886); *Cont'l Paper Bag Co. v. E. Paper Bag Co.*, 210 U.S. 405, 419 (1908) ("the claims measure the invention"); *McCarty v. Lehigh Valley R.R. Co.*, 160 U.S. 110, 116 (1895) ("if we once begin to include elements not mentioned in the claim, in order to limit such claim . . . we should never know where to stop"). *See also, Phillips v. A.H Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (*en banc*) ("It is a bedrock principle of patent law that the claims of a patent define the invention to which the patentee is entitled the right to exclude") (internal quotations and cite omitted).

invention is", it is "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms." *White v. Dunbar,* 119 U.S. 47 at 52.

Likewise, evidentiary findings regarding the contrasts between the claims are also necessary. When there are multiple claims of varying scope, each of the claims must be construed in light of the other claims of the patent. An obviously intended contrast in the words of different claims points to a difference in purpose and meaning.[2] *See also,* 37 C.F.R. § 1.75(b)[3].

A further principle is the primary importance of the specification in claim construction. Since a patent is an integrated instrument, the evidence of the accompanying written description or specification of the patent *must* be used to construe the claims.[4]

Additionally, this Court has also set forth the parameters of the doctrine of prosecution history estoppel. Estoppel

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2. *Smith v. Snow,* 294 U.S. 1, 13-14 (1935) ("The omission of these requirements from Claim 1 is the more pointed as the other claims of the patent speak in particular [of these additional elements]. Thus, by striking and obviously intended contrast with other claims, Claim 1 covers broadly the essential elements of the Smith invention as we have already described it"). This has also come to be known as the doctrine of claim differentiation, and embodies the common sense notion that the language of different claims should not be interpreted to make them identical in scope.

3. "More than one claim may be presented provided they differ substantially from each other".

4. "The claims of a patent are always to be read or interpreted in light of its specifications" *Schriber-Schroth Co. v. Cleveland Trust Co. et al.,* 311 U.S. 211, 217 (1940); *See also, Seymour v. Osborne,* 78 U.S. 516, 547 (1871) ("Where the claim . . . contains words referring back to the specifications, it cannot properly be construed in any other way").

arises when an amendment is made during prosecution to secure a patent, and the amendment narrows the patent's scope.[5]

With respect to the hierarchy between these principles, this Court's precedent provides that the words of the claims are paramount. *See e.g.*, fn. 1 *supra.*

3. Furthermore, since patents are technical documents written within the context of a field of engineering or science, this Court has long recognized that the inquiries in question require an assessment of evidence in light of the understanding of those skilled in that field. *See, United Carbon Co. v. Binned & Smith Co.*, 317 U.S. 228, 233 (1942) ("Here as in many other cases, it is difficult for persons not skilled in the art to measure the inclusions or appreciate the distinctions which may exist in the words of a claim when read in the context of the art itself.").[6] The same holds true in terms of assessing patent validity.[7]

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5. *See e.g., Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002).

6. *Markman*, 517 U.S. at 385-386

> ("The specifications . . . profess to describe mechanisms . . . and other manufactured products, which have their existence *in pais*, outside of the documents themselves; and which are commonly described by terms of the art or mystery to which they respectively belong; and these descriptions and terms of art often require peculiar knowledge and education to understand them aright . . . . Indeed, the whole subject-matter of a patent is an embodied conception outside of the patent itself . . . . This outward embodiment of the terms contained in the patent is the thing invented, and is to be properly sought, like the explanation of all latent ambiguities arising from the description of external things, by evidence *in pais*.")

(internal citation omitted); *General Electric Co. v. Wabash Appliance*

(Cont'd)

Thus, it is long established in this Court that to assess claim construction and patent validity, it is necessary to assess the understanding of those skilled in the art with respect to the plain meaning, the teachings of the specification, the contrasts between the claims, the distinctions between the claims as modified during prosecution and in the context of the prior art, and the effect of prior art itself. The questions of who is skilled in the art; the state of the art at the time of the invention; the meaning of specialized terms to that person; the problem a patent was solving; and whether a construction was disallowed during prosecution, are all relevant to construction.[8] This necessarily requires evidentiary findings at the trial court level.

At the same time, however, much of those findings have increasingly become superfluous, since the Federal Circuit affords them no evidentiary weight.[9] In the present case, however, the Court of Appeals went yet a step further, by upholding claim construction findings that were not even based on any real or articulated findings. With respect to the '620 patent, for example, none of the required evidentiary underpinnings were analyzed – at all – on the trial level with respect to construction of key claim terms such as the invert

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(Cont'd)
Corp., 304 U.S. 364, 372 (1938) ("we may doubt whether the language used in Claim 25, taken by itself, conveyed definite meaning to those skilled in the art of incandescent lighting").

7. *Seymour*, 78 U.S. at 555 (invalidity based on a prior reference requires an assessment in light of the understanding of one skilled in the art or science to which it appertains).

8. *See e.g., Phillips*, 415 F.3d at 1332 (Mayer, C.J., dissenting)

9. *Phillips*, 415 F.3d at 1330 (Mayer, C.J., dissenting); *Amgen, Inc. v. Hoechst Marion Roussel, Inc.*, 469 F.3d 1039 (2006) (Michel, C.J., dissenting).

limitation, which affected important issues of patent validity. Yet, the Court of Appeals nonetheless entered judgment without any such evidence of record.

Likewise, with respect to the '931 patent, evidence of the claim language, claim differentiation, the specification, and the plain meaning were all disregarded, and not even addressed in the Court of Appeal's decision – despite the primary importance of those factors under this Court's precedent. Instead, a new reading of prosecution disclaimer was adopted that is itself inconsistent with the long standing precedent of this Court.

The Technology

The patents in this case relate to no-spill drinking cups, which are used in the transition period when babies are moving from bottle feeding to normal drinking cups. At that time, young children often knock their cups over or shake them upside down, causing liquid to spill all over their environment. As a result, an industry has developed within the past several decades in these devices, which have liquid valves in them to prevent liquid spillage. Most parents prefer transitioning their children using these cups.

The engineering problems associated with designing these products encounter two opposite and competing requirements. On the one hand, the valves need to be designed to provide a tight seal to prevent liquid flow when force is applied upon turning the cup over or vigorously shaking it upside down. On the other hand, the valves need to be designed to provide a sufficiently weak seal so that liquid will flow out easily when a baby of limited strength attempts to drink.

Reconciling these two requirements can be difficult and has occasioned numerous patents in this field. The patents-

in-suit, U.S. Patent No. 6,321,931 ("the '931 patent") and U.S. Patent No. 6,357,620 ("the '620 patent") both claim inventions of Nouri E. Hakim ("Hakim") that have presented several elegant solutions to these problems.

The Patents

The two patents include a set of initial designs, and improved variations thereon. The broadest claims of the '931 patent, for example, were directed to a no-spill valve with a flexible membrane having an opening therein. In a closed position of the valve, the opening of the membrane rests against a fluid-impermeable blocking element, thereby sealing against fluid flow. (App. 58a, 70a). When the baby attempts to drink, negative pressure or a partial vacuum is applied against the membrane, causing the opening to rise away from the blocking element, and providing a path through the opening for liquid to emerge from the cup. (App. 58a, 70a).

In further improvements on the design, the membrane undergoes an unusual change of configuration during use. Namely, the membrane inverts (App. 62a, claim 10) or begins to invert (App. 54a, claim 12). In a further preferred embodiment, an anti-inversion member is placed above the membrane (App. 56a, claim 21).

The District Court Proceedings

After commercialization of Hakim's cups by his company, Luv n' care, Ltd., and positive market reception, Respondents began selling no-spill cups copying features of the patented valves that Hakim had introduced first into the market. Further thereto, Hakim filed suit for patent infringement in the U.S. District Court for the Western District of Louisiana.

In the district court, Hakim asserted a number of different patent claims against Avent, each of which had different limitations therein. He asked that the court hold a Markman hearing to construe the meaning of the claims, on a claim-by-claim, element-by-element basis, to address the evidentiary issues regarding the limitations in each claim to those of skill in the art, and their meaning in the context of the specification and other claims.

In response, the district court refused to hold a Markman hearing or to take any testimony. Rather, it entered patent claim construction and validity rulings without relying on any evidence from those of skill in the art, or addressing numerous of the evidentiary bases mandated by this Court.

For example, various claims included a limitation that the membrane inverts (App. 62a, claim 10) or begins to invert (App. 54a, claim 12) during use. Hakim demonstrated that the term "invert" requires a reversal in position, as per the specifications of both the '931 and '620 patents, and the understanding of one of skill. In other words, as shown in the figures (App. at 70a), the red surface of the membrane moves from being the inside surface of a bowl (see top left) to being the outside surface of a bowl (see bottom left)[10]. Put in another way, the red surface goes from concave to convex.

The district court, however, engaged in no analysis of what the term "invert" would mean to a skilled engineer in this art, or in any other definition. The court reduced the many claims of the '620 patent in dispute to just a single sentence,[11]

10. Color has been added to the figures in the appendix (which are taken from the patents-in-suit), for purposes of illustration and clarity.

11. "[B]oth of these extremely simple devices are made so that, when a child sucks on the spout, the flexible member flexes up the post, breaking the seal, and allowing the flow of liquid." (App. 30a).

ignoring the particular terms used in each of those very different claims.

In fact, Hakim was told that the specific claim limitations are not important. In surprising fashion, the court rejected Hakim's basic request that it engage in construction of the term 'invert', deriding Hakim's insistence on a precise claim construction as "semantical gymnastics". (App. 30a).

Instead of construing the disputed limitations, the court stated that the particular claim terms "matter not". (App. 30a) It expressly refused to draw any distinction between the meaning of the term "invert" and very different terms such as "flex", "slide", "move", "lift", "or any other term denoting movement" (App. 30a).

Yet each of those descriptions of the membrane's dynamics have very different implications to those skilled in designing products in this field. They represent different structural and functional descriptions of the membrane's response to the forces applied during use, which have significant practical ramifications from the perspective of the engineers designing these valves.

There was no indication that the district court made any effort to understand these distinctions, that it actually construed the term invert, or that engaged in any of the predicates required by this Court to do so. None of the evidentiary underpinnings required by this Court were ever cited or given weight. It conducted no analysis of the specification with respect to the invert term, gave no weight to the differences between the claims (some of which required inversion and some of which didn't), and cited no prosecution history.

In short, no evidentiary findings whatsoever were conducted by the district court as to the invert limitation for claim construction purposes. Similarly, no evidence was cited

by the district court pointing to any prior art having the specific invert limitation therein. Although the defendants had cited a foreign patent reference against the patent, the court identified no evidence that the inversion feature was actually in that reference. Nonetheless, the district court invalidated the inversion claims of the patent anyway, contrary to this Court's precedent.[12]

The issue in the '931 patent was likewise one of claim construction; namely, whether claims to an "opening" include a hole. The district court ruled that the hole in defendant's products is not an opening. The court effectively limited the term opening to the properties of a slit, based on prosecution remarks in a parent application that discussed the benefits of using a slit in the membrane. In fact, however, that parent application was abandoned; in the continuation which actually issued as the '931 patent, an amendment was entered to remove "slit" from all of the independent claims to broaden it to the issued "opening" language.

The Federal Circuit Decision

On appeal, the Federal Circuit affirmed. With respect to the "invert" limitation, the Court of Appeals identified no evidence in the record as to what one of skilled in the art would specifically understand regarding this unusual change in membrane configuration. No analysis was conducted of the specification and its figures with respect to the term. Nor was any discussion, weight or consideration given to the evidence to be understood from the differences between the claims in suit. Although these are all evidentiary

12. *Seymour*, 78 U.S. at 555 (invalidity based on a prior reference requires an assessment in light of the understanding of one skilled in the art or science to which it appertains).

predicates under this Court's precedent, none of them were addressed.[13]

Rather, the Court criticized Hakim's methodological position. (App. 11a).[14] That rejection of his request for reasoned explicit evidentiary findings goes to the heart of the fundamental problems with current claim construction. This Court has set forth a specific evidentiary foundation which must be surveyed for any principled construction to be conducted.

With respect to the '931 patent, the Court of Appeals upheld the district court's decision that Hakim emphasized the "slit" during prosecution of a parent application to distinguish the claims from the cited references. However, at the time Hakim made those statements during prosecution, "slit" was expressly recited in several independent claims. Hakim later abandoned those claims and in the continuation application which actually issued as the '931 patent, he deleted the term "slit" from all independent claims having it and replaced it with "opening". (App. 59a-61a, claims 1, 3,

13. Likewise, any question of who qualifies as one of ordinary skill in the art; the meaning and scope of the patent terms to that person; the state of the art at the time of the invention; and the problem the patent was solving; were all disregarded.

14. It asserted that Hakim did not state what meanings for the terms would affect validity or assert that the district court's analysis was incorrect, though Hakim, in fact, did so expressly and repeatedly throughout his appeal briefs. *See, Appellant's Brief* at 48-50; *Reply Brief* at 28-29. For example, for the claims relating to inversion, Mr. Hakim stated that inversion requires a reversal in position, such that an outside surface becomes an inside surface and an inside surface becomes an outside surface (e.g. concave becomes convex or vice versa). *Appellant's Brief* at 49-50; *Reply Brief* at 28. He also showed that the cited prior art does not teach or suggest this, and demonstrated that the outside and inside of the IT '286 membrane was not even capable of inversion. *Appellant's Brief* at 49; *Reply Brief* at 26-28.

and 5). He specifically moved the term slit into various dependent claims only. (App. 64 a, claims 27, 28 and 29).

In the prosecution history, he likewise stated that he was deleting the term slit, to broaden the scope of the independent claims to an opening. Furthermore, the specification expressly defined the term opening as including a hole. (App. 59a).

The Court of Appeals, however, held the term "opening" to the meaning of the prior slit limitation, despite the fact that "slit" had been removed by amendment, since Hakim hadn't 'rescinded' his prior remarks during prosecution. It gave no weight to the fact that the continuation application which actually gave rise to the '931 patent was amended to delete the term slit from the independent claims for the express purpose of broadening it. It also gave no weight to the specification definition, which must be adhered to under this Court's precedent, and which expressly defined an opening as including a hole. (App. 59a). It likewise gave no weight to the various dependent claims that specifically claimed a slit, requiring a reading under this Court's precedent that the opening language in the independent claims is not limited to a slit. It also gave no weight to the evidence that one of skill in this field would certainly recognize that the plain meaning of "opening" includes a hole.[15]

In fact, the specification definition, claim differentiation, and plain meaning to those skilled in the art – all necessary evidentiary predicates under this Court's precedent – were not even addressed in the court's decision.

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15. *See also, Display Techs. v. Paul Flum Ideas, Inc.*, 282 F.3d 1340, 1345 (Fed. Cir. 2002) ("The ordinary definition of the term 'aperture' is 'an opening; hole; gap.'")

REASONS FOR GRANTING THE PETITION

I. THE FEDERAL CIRCUIT'S NEWEST RULE OF PROSECUTION DISCLAIMER IS CONTRARY TO THIS COURT'S PRECEDENT

1. The Court of Appeals' new rule of prosecution history disclaimer, which allows claim limitations to be read back into the claims after they are removed, is fundamentally inconsistent with this Court's long standing precedent. Elimination of a term from a claim signals a change in scope, such that the eliminated term and its properties cannot be read back into the claim. "It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent." *Schriber-Schroth Co.*, 311 U.S. at 220-221. It is an established principle that "an abandoned claim cannot be revived and restored to the patent by reading it by construction into the claims which are allowed." *Id.* at 218. The fact that the earlier claim was narrower and then broadened does not change this. "True, the rule is most frequently invoked when the original and cancelled claim is broader than that allowed, but the rule and the reason for it are the same if the cancelled or rejected claim be narrower." *Id.* at 221.

2. Furthermore, with respect to the legal hierarchy between different sources of evidence, this Court's precedent provides that it is the words of the claims themselves which are paramount. *Merrill v. Yeomans*, 94 U.S. 568, 570, 24 L.Ed. 235 (1876) (the claims are "of primary importance, in the effort to ascertain precisely what it is that is patented."); *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339, 81 S.Ct. 599, 5 L. Ed.2d 592 (1961) ("the claims made in the patent are the sole measure of the grant");

See also, White v. Dunbar, 119 U.S. 47, 52, 7 S.Ct. 72, 30 L.Ed. 303 (1886) (Because the patentee is required to "define precisely what his invention is," the Court explained, it is "unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms."); *Cont'l Paper Bag Co. v. E. Paper Bag Co.,* 210 U.S. 405, 419, 28 S.Ct. 748, 52 L.Ed. 1122 (1908) ("the claims measure the invention"); *McCarty v. Lehigh Valley R.R. Co.,* 160 U.S. 110, 116, 16 S.Ct. 240, 40 L.Ed. 358 (1895) ("if we once begin to include elements not mentioned in the claim, in order to limit such claim . . . we should never know where to stop"). It is not the role of prosecution history to change the plain terms of the claims. *Goodyear Dental Vulcanite Co. v. Davis,* 102 U.S. 222, 227 (1880).

3. It is further significant that the slit limitation previously argued was explicitly moved out of the independent claims and into dependent claims. Under this Court's claim construction principles, limitations in the dependent claims may not be imputed to independent claims which do not recite them. *Smith v. Snow, et al.*, 294 U.S. 1, 13-14, 55 S.C. 279, 284 (1935).[16] That principle was also not addressed in the court's decision.[17]

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16. ("The omission of these requirements from Claim 1 is the more pointed as the other claims of the patent speak in particular [of these additional elements]. Thus, by striking and obviously intended contrast with other claims, Claim 1 covers broadly the essential elements of the Smith invention as we have already described it").

17. The doctrine of claim differentiation is embodies the common sense notion that the language of different claims should not be interpreted to make them identical in scope. Even under the Federal Circuit's own case law, the placement of the slit language in dependent claims results in a heavy presumption against the independent claims being limited to a slit. *See also, Phillips v. AWH Corp.*, 415 F.3d 1303, (Cont'd)

4. When claim scope is changed during prosecution, this Court has instructed that the specification is to be consulted to determine the proper meaning of disputed claim terms: "the amended and cancelled claims are to be read in the light of the specifications." *See, Schriber-Schroth Co. v. Cleveland Trust Co. et al.*, 311 U.S. 211, 222, 61 S.C. 240 (1940). Yet, the specification expressly defined the term opening as covering any form of opening, including a hole. (App. 59a). The specification definition was also not addressed by the Federal Circuit.

The court's failure to give weight to the specification elevates old remarks in a parent application above the express definition in the specification and the terms of the claims as finally issued. This is analogous to making legislative history about initial language in a draft statute – initial language never enacted but instead amended – more important than the definition in the statute and the broader, plain terms of the statute as actually and finally enacted. The role of prosecution history is to understand the meaning of the claims

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(Cont'd)

1315 (Fed. Cir. 2005) (en banc) ("[T]he presence of a dependent claim that adds a particular limitation gives rise to a presumption that the limitation in question is not present in the independent claim."); *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 910 (Fed. Cir. 2004); *Tandon Corp. v. United States Int'l Trade Comm'n*, 831 F.2d 1017, 1023 (Fed. Cir. 1987). The Court of Appeals' own presumption was not addressed anywhere in its decision. Under claim differentiation, when broad independent claims reciting a general term are followed by dependent claims reciting a specific example of that term, the independent claims are not limited to the specific example, but must be interpreted generally. Thus, for example, an independent claim claiming the use of wood, followed by a dependent claim reciting that the wood is mahogany, demonstrates that the independent claims are not limited to mahogany, but rather encompass any type of wood.

– not to change the plain terms of them. *Goodyear,* 102 U.S. at 227 (although the prosecution history should be used to understand the language used in the patent, it cannot "enlarge, diminish, or vary" the limitations in the claims.").

5. The error in the Federal Circuit's approach is particularly significant since the specification definition is what the Patent Office relies on during the application process. As set forth in the Code of Federal Regulations, the meaning of the claim language when the applicant is applying for a patent is determined by reference to the specification.[18] The internal guidelines followed by Examiners in the Patent Office provide likewise. *See, Manual of Patent Examining Procedure* § 2111 (during examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification); *see also, In re Hyatt,* 211 F.3d 1367, 1372 (Fed. Cir. 2000). Clearly, the broadest interpretation of an opening (or any interpretation for that matter) includes a hole.

By assuming that the Examiner did not give a claim term ("opening") the scope set forth in the specification at the time of the amendment, the decision conflicts with the very principles followed by the Patent Office during prosecution of the claims. As such, it works fundamental unfairness by applying a different set of principles after issuance of the patent than were applied during examination at the Patent Office.

6. This is further exacerbated by the fact that the applicant's actions were fully consistent with the Court of Appeals' own precedent which was in effect at the time of

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18. *See,* 37 C.F.R. §1.75(d)(1) ("The claim or claims must conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description").

amendment. That precedent provided that a limitation (here, the "slit") may not be read back into the claims after it is expressly removed during prosecution.[19] It also held that for prosecution disclaimer to be found, it must be clear and unambiguous such that there is an unmistakable surrender of the claim scope in question during prosecution. *See, 3M,* 350 F.3d at 1373. An applicant's removal of a limitation to broaden the claim is totally inconsistent with the notion that the applicant unmistakably wished to be limited to that pre-amendment, limitation or to remarks regarding it.

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19. In *Telectronics,* for example, the patentee argued that the use of a skin electrode – expressly recited in the pending claims – was a distinguishing feature of the invention. *United States v. Telectronics, Inc.,* 857 F.2d 778, 782 (Fed. Cir. 1988). The claims were later amended to remove the skin electrode limitation. *Id.* at 783. This Court ruled that "arguments emphasizing the use of a skin electrode, which were made at the time the application claims explicitly contained such a limitation, cannot furnish a basis for restricting [an issued claim], which lacks any such limitation." *Id. See also, 3M Innovative Properties Co. v. Avery Dennison Corp.,* 350 F.3d 1365, 1372 (Fed. Cir. 2003) ("A broadening amendment made during the prosecution history . . . supports a plain-meaning construction . . . without a sequential-embossment limitation . . . . The fact that 3M broadened its claims . . . and dropped the sequential limitation is perhaps unusual, but it is entirely permissible, and the plain language of the claim as issued must control."); *Kistler Instrumente AG v. United States,* 628 F.2d 1303, 1308 (Ct. Cl. 1980)

> ("It is significant that none of the claims in the patent which ultimately issued contain the narrow limitation of original claim 2 . . . . *It must be concluded that the Patent Office did not feel that this was a critical limitation. Thus, defendant's insistence upon this court's reading back into the claims limitations which were originally there and were removed during prosecution of the application through the Patent Office cannot be permitted.*"

(Emphasis added).

7. Furthermore, by flagging his amendment to the Examiner and letting him know that he was broadening the claims, an applicant does what is entirely reasonable, and should logically expect that the claims are being broadened under then-existing law. The placement of the limitation in question into dependent claims yet further signals to the examiner that only the dependent claims were being limited to a slit and not the independent ones. 37 C.F.R. § 1.75(b). Consistent with established Patent Office practice, the Examiner necessarily considered the definition set forth in the specification and the broadest reasonable meaning of the claims, and must have treated the word opening as being broader than a slit, and including a hole.

The Court of Appeals' decision necessarily assumes that the Examiner did not examine the claims, which is without any reasonable basis, and which is contrary to this Court's precedent as well. *United States v. Chemical Foundation,* 272 U.S. 1, 14-15 (1926) ("The presumption of regularity supports the official acts of public officers, and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties")[20].

Applicants removing limitations from their claims had every reason to expect that their actions were sufficient to broaden the claims, and there is every reason to expect that Patent Examiners believed likewise, based on the Code of Federal Regulations and the Patent Office's own internal procedures. But under this new precedent, thousands of patentees will be penalized for following practices consistent

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20. *See also, Intervet America, Inc. v. Kee-Vet Labs., Inc.,* 887 F.2d 1050, 1054 (Fed. Cir. 1989)

> ("The presumption of validity under 35 U.S.C. § 282 carries with it a presumption the examiner did his duty and knew what claims he was allowing . . . the claims as allowed are what we have to deal with and it is not for the courts to say that they contain limitations which are not in them.").

with this Court's precedent, and the Court of Appeals' own *Telectronics* precedent in effect at the time they prosecuted their applications. Amendment of claims to broaden them is extremely common during patent prosecution – under this new rule, the patent protection that should have resulted is eviscerated, allowing copyists to improperly gain free access to the benefits of inventions requiring extensive research and investment that they did not contribute to.

7. Under the Court of Appeals' decision, there is a new presumption that no difference is recognized or considered by Patent Examiners at the time of amendment unless an additional "rescinder" is entered by the applicant.[21] That presumption is also contrary to precedent. When a claim is amended from one term to another, it must be deemed that "By the amendment [the patentee] recognized and emphasized the difference between the two phrases." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 734 (2002). By its very nature, removal of a term from a claim removes any basis for restricting claims based on earlier remarks about that term. This new presumption also gives no weight to the applicant's express statement to the Examiner that he is broadening the claims.

8. Thus, the CAFC's holding creates a new rule requiring patentees that have broadened their claims through amendment to take the additional – and previously unprecedented – step of expressly rescinding the prior scope

21. In fact, while the court held that the Examiner allowed the continuation claims without further prosecution (App. 8a), that was inaccurate. Applicant submitted an IDS in the continuation which brought further references to the Examiner's attention, and argued that the slit term is broader than opening. Since he had to examine those references vis-a-vis the claims, he could not have failed to notice that the language was broader, and not limited to a slit. His allowance of the claims demonstrates that the properties of a "slit" were not regarded as necessary for patentability.

of the claim. This new rule will affect thousands of issued patents where the practitioner and the Examiner understood exactly what was taking place, but cannot point to an express statement of rescission.

The decision effectively requires a further "disclaimer of any prior disclaimer" to repudiate a limitation, beyond its explicit deletion from the claims. It significantly, and unfairly, reduces the value of large numbers of unexpired patents with broadened claims, in many cases entirely eliminating the benefits of the broadening. *See Warner-Jenkinson Co. v. Hilton-Davis Chem. Co.*, 520 U.S. 17, 32 (1997) ("To change so substantially the rules of the game now could very well subvert the various balances the PTO sought to strike when issuing the numerous patents which have not yet expired and which would be affected by our decision.").

By this new rule – which applies with no prior notice to those whose patents have already issued – the Federal Circuit is effectively restaking the position that a surrender of subject matter during prosecution precludes recapturing that subject matter, even if equivalent to the subject matter expressly claimed. That position was already explicitly rejected by this Court. *Id.* at 30-31.

II. ARTICLE I OF THE CONSTITUTION AND THIS COURT'S MARKMAN DECISION REQUIRE A CONSISTENT EVIDENTIARY METHODOLOGY FOR CLAIM CONSTRUCTION DETERMINATIONS

Perhaps the greatest problem facing the patent field today is the unpredictability of the Federal Circuit's approach to any given question of claim construction. The most recent study, for example, has found that more than one in every

two claim constructions rulings is reversed on appeal.[22] Other earlier studies have come to similar results.[23] In other words, one has no more than a coin toss's chance of divining the ultimate claim construction conclusion of a Federal Circuit panel.[24] *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting) (this reversal rate, hovering near 50%, is the worst possible). Furthermore, a CAFC panel can even adopt a claim construction contrary to the one it has itself previously adopted.[25]

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22. Michael Saunders, Note, A Survey of Post-Phillips Claim Construction Cases, 22 Berkeley Tech. L.J. 215 (2007) (the overall reversal rate in claim construction cases, excluding summary affirmances, is 53.5%, and the percent of cases where at least one construction changed is 39.5%).

23. *See e.g.*, Christian A. Chu, Empirical Analysis of the Federal Circuit's Claim Construction Trends, 16 Berkeley Tech. L.J. 1075, 1092 (2001) (finding an overall reversal rate of 47.3% excluding Rule 36 affirmances and 36.6% including such affirmances); *Cybor Corp. v. FAS Techs., Inc.*, 138 F.3d 1448, 1476 (Fed. Cir. 1998) (Rader, J., dissenting) ("Nonetheless, one study shows that the plenary standard of review has produced reversal, in whole or in part, of almost 40% of all claim constructions since Markman I.")

24. *See also, Phillips*, 415 F.3d at 1330 ("What we have wrought . . . is the substitution of a black box, as it so pejoratively has been said of the jury, with the black hole of this court. Out of this void we emit "legal" pronouncements by way of "interpretive necromancy"; these rulings resemble reality, if at all, only by chance.").

25. *Cybor*, 138 F.3d at 1476-1477 (Randall, J., dissenting)

> ("One other case makes the point even more persuasively. In *CVI/Beta Ventures, Inc. v. Tura LP* . . . the Federal Circuit reversed its own earlier claim interpretation as a question of law when the defendant and stage of the proceedings changed . . . . Although this court referred to the New York district court's "error," the Federal Circuit had in fact reversed itself.").

Such uncertainty is completely contrary to the express requirements of this Court. This Court has unequivocally rejected the prospect of a "zone of uncertainty" as to the scope of patent claims, and has done so repeatedly since the enactment of the Patent Act of 1836. *Markman,* 517 U.S. at 390; *United Carbon,* 317 U.S. at 236. Nothing can be more just and fair, both to the patentee and to the public, than that they should be able to reliably assess the correct scope of the claims of a patent. *Merrill,* 94 U.S. at 573.

The protection of rights in new inventions was sufficiently important to the founders that it was expressly enshrined in Article I, Section VIII.[26] The Constitution mandates that inventors must be secured the exclusive rights to their discoveries to promote the progress of science and the useful arts. The requirement for *secure* rights necessarily requires a predictable and consistent claim construction regime, for the benefit of inventors no less than the public.

As this Court stated over a hundred years ago,

> "[t]he growth of the patent system . . . has reached a stage in its progress where the variety and magnitude of the interests involved require accuracy, precision, and care in the preparation of all the papers on which the patent is founded . . . The public should not be deprived of rights supposed to belong to it, without being clearly told what it is that limits these rights".

Merrill, 94 U.S. at 573.

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26. . . . . "To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries".

Likewise, as reaffirmed in *Markman*, "the limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public." *Markman,* 517 U.S. at 390, *citing General Electric,* 304 U.S. at 369. A claim construction regime with the current level of unpredictability fails to meet the requirements of this Court and the Constitution.

Even the judges of the Federal Circuit have candidly recognized the importance of predictability in the field.[27] But despite that court's recognition of the problem, and no doubt

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27. *See e.g.,* Hon. Paul R. Michel, A Review of Recent Decisions of the United States Court of Appeals for the Federal Circuit: Introduction: the Challenge Ahead: Increasing Predictability in Federal Circuit Jurisprudence for the New Century, 43 Am. U. L. Rev. 1231, 1233 (1994)

> ("I believe the court has failed in one respect. While greatly improving doctrinal clarity and national consistency, we have done little to increase predictability . . . By "predictability," I mean that the actual outcome of potential litigation may be accurately forecast through the consistent application of clearly stated legal principles to new factual situations");

Hon. Pauline Newman, Introduction: the Federal Circuit: Judicial Stability or Judicial Activism? 42 Am. U. L. Rev. 683, 688 (1993) ("Indeed, unless there can be reasonable reliance on legal advice given during the stages of invention and innovation, unless that advice can correctly predict the legal principles to be applied by the court, the court is not fulfilling its obligations to the public"); Hon. Randall R. Rader, The United States Court of Appeals for the Federal Circuit: the Promise and Perils of a Court of Limited Jurisdiction, 5 Marq. Intell. Prop. L. Rev. 1, 11 (2001) ("You need to have a clear standard that you can conform your conduct to. When the lawyers can say, "I have four cases here, four cases there, take your pick." That is not a happy situation for a CEO or a Dot Com start-up company or any one else.")

its best intentions, it is abundantly clear that predictability has been long absent.

The continuing unpredictability in the claim construction enterprise is amply demonstrated by this case. With respect to the '931 patent, the court adopted a new rule of disclaimer that changes the scope and value of thousands of patents previously issued under prior precedent. It did so without even addressing the contrary weight of this Court's primary principles of claim interpretation. With respect to the '620 patent, the court upheld claim construction rulings regarding claim terminology ("invert"), when absolutely none of the evidentiary underpinnings required by this Court's precedent were addressed at the district or appellate level.

Although Markman addressed the role of the judge in claim construction, it has been numerous decades since any substantive rulings have been issued by this Court regarding the evidentiary factors that must be addressed during claim construction and the means for choosing between competing principles in claim construction when they arise. Thus, the Federal Circuit rarely directly relies on this Court's precedent for claim construction issues regarding literal infringement. For example, of the 24 claim construction decisions issued this year from January 1-July 23, 2007 (other than the present case), none appear to have directly relied on any decisions of this Court to guide questions of claim construction. Indeed, only one of those 24 appears to even have cited any decisions of this Court to guide such questions, and that reference was in a dissenting opinion by a new member of the court of appeals. *See, Acumed LLC v. Stryker,* 483 F.3d 800, 814 (Fed. Cir. 2007) (Moore, J., dissenting).

This underscores the importance of an explicit methodology of claim construction from this Court, confirming the factual and legal roles to be given to the

various evidentiary predicates,[28] and the means for choosing between legal principles when they conflict. "The necessity of a sensible and systematic approach to claim interpretation is axiomatic. The Alice-in-Wonderland view that something means whatever one chooses it to mean makes for enjoyable reading, but bad law."[29] Without definite and firm direction by this Court as to the specific methodology that must be regularly followed in claim construction, the current inconsistency and unpredictability will continue and likely only worsen.

CONCLUSION

For the reasons stated, the petition for a writ of certiorari should be granted.

Respectfully submitted,

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28. *See e.g., Phillips*, 415 F.3d at 1331 ("there can be no workable standards by which this court will interpret claims so long as we are blind to the factual component of the task.") (Mayer, C.J., dissenting).

29. *See e.g., Autogiro Co. of America v. United States*, 384 F.2d 391, 396-97 (Ct. Cl. 1967).

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DECIDED FEBRUARY 23, 2007

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

05-1398

NOURI E. HAKIM,

Plaintiff-Appellant,

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED AND AVENT AMERICA, INC.,

Defendants-Appellees.

JUDGES: Before MICHEL, Chief Judge, NEWMAN and RADER, Circuit Judges.

NEWMAN, Circuit Judge.

Mr. Nouri E. Hakim sued Cannon Avent Group, PLC, Cannon Rubber Limited, and Avent America, Inc. (together "Avent") in the United States District Court for the Western District of Louisiana, asserting infringement of Hakim's United States Patents No. 6,321,931 (the 2931 patent) and No. 6,357,620 (the 2620 patent), by Avent's leak-resistant drinking cups. The district court granted Avent's motions for summary

judgment that the 2931 patent is not infringed and the 2620 patent is invalid.[1] We affirm these judgments.

THE *'931 PATENT*

The Hakim inventions are for drinking cups that prevent the spilling of liquid if the cup is tipped over. Hakim's patented cups have a valve through which fluid can pass when suction is applied by a person by way of a drinking spout, whereby the valve closes to seal the cup when a person is not drinking. The specification of the '931 patent describes the preferred embodiment as having a dual sealing mechanism that provides an "extremely secure seal" against spillage:

> In accordance with the invention, an improved cup construction and valve assembly is provided which provides an extremely secure seal against accidental liquid flow from the cup spout. Further to the invention, a user places his or her mouth against the spout of the cup assembly to suck liquid out of the cup when desired. The act of sucking at the spout of the cup creates negative pressure or a partial vacuum against a valve in the cup spout, causing the valve to invert, or turn inside out, either partially or totally, thereby unblocking an opening such as an orifice or slit

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1. *Hakim v. Cannon Avent Group, PLC*, No. 3-02-1371, 2005 WL 1793760 (W.D.La. May 4, 2005) (the 2931 patent) ("*Hakim I*"); *Hakim v. Cannon Avent Group, PLC*, No. 3-02-1371, 2005 WL 1793765 (W.D.La. May 4, 2005) (the 2620 patent) ("*Hakim II*").

in the valve. Once the opening is unblocked, liquid can flow freely through the valve and spout.

In contrast, when not in use, the valve sits in a resting, closed position, with the valve pressed against the center seal-off, thereby sealing off the opening or slit in the valve assembly. Thus, in its relaxed state, with no negative pressure applied, the valve sits in a closed position with the fluid opening sealed by the center seal-off. Moreover, in accordance with the dual valve nature of the device in the preferred embodiment, an adjacent valve similarly seals when no negative pressure is applied, thereby blocking off the air vents in the cover of the cup, and further preventing the possibility of fluid flow. Consequently, the closed position provides an extremely secure seal against fluid leakage, such that inadvertent spills or even deliberate attempts to force liquid outside of the cup, such as by turning the cup upside down, or shaking the cup, are ineffective.

'*931 Patent*, col. 1, line 51 to col. 2, line 10.

During patent prosecution Hakim described his distinctions from the cited references as follows:

Thus two separate mechanisms are both used to close off the passage of liquid through the valve when not in use. The first mechanism involves an inverting, *flexible valve material which has a slit* therein and responds to suction. The second

> mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, to yet further prevent the passage of liquid through the valve.
>
> . . . . By providing *both the elastomeric member with a slit and a blocking element,* a sealing mechanism is provided which reduces spillage beyond that of either mechanism alone. None of the references cited in the Office Action [Robbins III, Bachman, and Belcastro] teach or suggest such *a no-spill mechanism having a slit sitting against a blocking element such as is recited in all of the pending claims.*

'931 Application Response, Oct. 2, 2000 (emphases added). Thus during prosecution the presence of the slit in the flexible valve material was emphasized as distinguishing all of the claims from the cited references.

Avent's accused drinking cup has a valve with a flexible diaphragm having a central opening, but the opening is not a slit that opens and closes, but simply a hole in the diaphragm. The diaphragm rests against a plastic mount that has a conical head that seals the hole. Upon suction by a person seeking to drink, the diaphragm is lifted off the conical head, exposing the hole and permitting fluid to flow from the cup to the drinking spout.

The district court held on summary judgment that Avent's device did not infringe the '931 claims, based on the claim

construction that limited the 2931 claims to a sealing mechanism that includes a flexible valve material or diaphragm having a slit. *Hakim I* at *1 ("For the reasons contained in the Report and Recommendation of the Magistrate Judge previously filed herein, and after a de novo review of the entire record and the written objections filed herein, and concurring with the Magistrate Judge's findings under the applicable law"; summary judgment was granted.) Mr. Hakim argues that the claim construction is excessively constricted and that all of the '931 claims do not require a slit that opens and closes with pressure, for claims 1 and 2 use the word "opening," not "slit," for the aperture in the diaphragm. Claim 1 is as follows:

> 1. An apparatus for use in a no-spill drinking cup, said apparatus comprising:
>
> a valve holder, such valve holder comprising at least one valve and a blocking element, said valve comprising a flexible material, said blocking element comprising an area of material which is impenetrable to the flow of liquid, said valve further comprising *an opening through said flexible material,* said valve having a resting position wherein said flexible material sits with said opening against said blocking element such that said valve is closed to the passage of liquid through said valve, said valve moving into an open position for the passage of liquid through said valve upon the application of negative air pressure to the top of said valve, said open position being a position wherein said flexible member

comprising said opening lifts off of said blocking element.

(Emphasis added.) The word "opening" was placed in claims 1 and 2 when Hakim filed a continuation application after receiving a notice of allowance for claims wherein the word "slit" appeared instead of "opening." The filing of the continuation was accompanied by an attorney letter stating that Hakim was broadening claims 1 and 2, and an amendment changing "slit" to "opening" in claims 1 and 2. The continuation claims were allowed without any comment or rejection by the examiner. However, in construing the claims of the continuation patent, the district court held Hakim to his arguments in the parent application that the invention includes the presence of a slit in the flexible material. The court stated: "Because Hakim did not retract any of his arguments distinguishing the prior art, he is held to the restrictive claim construction he argued during prosecution of the patent." *Hakim I* at *5 (adopted Magistrate's Report).

Hakim argues that the district court improperly relied on the argument in the abandoned parent application. Hakim states that by re-filing the application with broader claims, he avoided any unnecessary restriction that may have crept into the prior prosecution. He states that he informed the examiner that the new claims were broader than those previously allowed, and that when the examiner allowed the new claims without rejection, there is a presumption that the examiner had assured himself of the patentability of the new claims. *See United States v. Chemical Foundation,* 272 U.S. 1, 14-15, 47 S.Ct. 1, 71 L.Ed. 131 (1926) ("The presumption

of regularity supports the official acts of public officers, and, in the absence of clear evidence to the contrary, courts presume that they have properly discharged their official duties.") Hakim states that he did what was appropriate when he flagged this change to assist the examiner, and that the claims as granted should not be unnecessarily narrowed by the court.

Avent states that the totality of the prosecution history nonetheless limits Hakim to the embodiment with the slit, for the magistrate judge found: "The prosecution history makes perfectly clear that Hakim specifically distinguished his invention from the prior art by limiting it to an apparatus with both (1) a slit which closes when suction is not applied, and (2) a second closure consisting of a blocking element which the slit rests against." *Hakim I* at *5 (adopted Magistrate's Report). Avent states that this was and is the distinction from the prior art, and that the claims are properly limited to this feature whether they use the word "slit" or the word "opening." Avent stresses that when Hakim wrote to the examiner that he was broadening the claims, he did not specifically point out that he no longer intended to be limited to the specific mechanism that he had previously argued was the distinguishing feature of his invention.

Hakim points out that a patent applicant is not precluded from filing a continuation application with broader claims. It is recognized that an applicant can broaden as well as restrict his claims during the procedures of patent examination, and that continuing applications may present broader claims than were allowed in the parent. *Cf. Symbol Technologies, Inc. v. Lemelson Medical, Education &*

Research Found., 422 F.3d 1378, 1385 (Fed.Cir.2005) ("Commonly, and justifiably, one might refile an application to add subject matter in order to attempt to support broader claims as the development of an invention progresses, although entitlement to an earlier filing date for any claimed subject matter may of course be necessary to avoid a statutory bar created by intervening events outlined in 35 U.S.C. §§ 102 and 103.").

Hakim had the right to refile the application and attempt to broaden the claims. *See id.* at 1385 ("One may also refile an application even in the absence of any of these reasons [refiling an application in response to a requirement for restriction; refiling in order to present evidence that may not have previously existed; or refiling to support broader claims as the development of an invention progresses], provided that such refiling is not unduly successive or repetitive.") However, an applicant cannot recapture claim scope that was surrendered or disclaimed. The district court did not err in holding that the examiner's action in allowing the continuation claims without further prosecution was based on the prosecution argument in the parent. *See Omega Engineering, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed.Cir.2003) ("The doctrine of prosecution disclaimer is well established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution.") (citing *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21, 61 S.Ct. 235, 85 L.Ed. 132 (1940), *Crawford v. Heysinger*, 123 U.S. 589, 602-04, 8 S.Ct. 399, 31 L.Ed. 269 (1887), and *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227, 26 L.Ed. 149 (1880)). Although a disclaimer

made during prosecution can be rescinded, permitting recapture of the disclaimed scope, the prosecution history must be sufficiently clear to inform the examiner that the previous disclaimer, and the prior art that it was made to avoid, may need to be re-visited. *See Springs Window Fashions LP v. Novo Indus., L.P.,* 323 F.3d 989, 995 (Fed.Cir.2003) ("The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during the prosecution of his patent. A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement.").

The district court correctly ruled that the word "opening" is not correctly construed to eliminate the sealing mechanism provided by the slitted diaphragm. On this construction, the summary judgment of noninfringement of the *'931 patent* was correct, and is affirmed.

THE '620 PATENT

The *'620 patent* also describes a valve containing a diaphragm with an opening, but the opening surrounds a conical post protruding from the surface of the blocking element; when suction is applied to the spout of the cup, the diaphragm is lifted off of the blocking element, permitting fluid to flow through the opening. Hakim describes this invention as follows:

> In the preferred embodiment, the application of negative pressure to the top of the valve causes

> an opening in a portion of the valve to move up off of the base of a protruding member extending through that opening. Once the opening is unblocked, liquid can flow freely through the valve and spout.
>
> In contrast, when not in use, the valve sits in a resting, closed position, with the opening pressed against the center seal-off, thereby sealing off the opening, slit or orifice in the valve assembly. Thus, in its relaxed state, with no negative pressure applied, the valve sits in a closed position with the fluid opening sealed by the center seal-off. In the preferred embodiment, the protruding member extends through the opening in a male to female relationship such that the orifice sits tightly on the protruding member against the protruding member's bottom portion and the center seal-off or sealing member's base.

'620 Patent, col. 1, line 51 to col. 2, line 9.

The district court granted summary judgment that the claims of the '620 patent are invalid based on anticipation by Italian Patent No. 594286 (the IT '286 patent). The IT '286 patent was not before the United States examiner, whereupon the district court analyzed the reference to determine its relevance and effect.

Appendix A

A

Hakim argues that the district court erred in invalidating the 2 620 patent without first construing the claims, citing *Amazon.com, Inc. v. Barnesandnoble.com, Inc.*, 239 F.3d 1343 (Fed.Cir.2001) for the proposition that an invalidity analysis begins with the construction of the claims.

Claim construction is directed to claims or claim terms whose meaning is disputed as applied to the patentee's invention in the context of the accused device. When there is no dispute as to the meaning of a term that could affect the disputed issues of the litigation, "construction" may not be necessary. We are not told what alternative meanings are sought for terms that might affect validity of the claim, or how claim "construction" would affect the issue of anticipation by the Italian patent. Hakim's methodological challenge is without substance.

B

"Anticipation" means that the claimed invention was previously known, and that all of the elements and limitations of the claim are described in a single prior art reference. *See Akzo N.V. v. U.S. Int'l Trade Comm'n*, 808 F.2d 1471, 1479 (Fed.Cir.1986) ("Under 35 U.S.C. § 102, anticipation requires that each and every element of the claimed invention be disclosed in a prior art reference.") The magistrate judge found that the drinking cup described in the IT 2286 reference and the drinking cup in the *'620 patent* "are substantially identical in all material respects," explaining:

Appendix A

> Both inventions have a flexible valve member or diaphragm, a base and a protruding member or post, called a peduncle in the IT '286 patent. The post extends through a hole in the valve member and, when at rest in its closed position, the valve member sits tightly around the lower portion of the post in both inventions. When a child sucks on the spout, the valve member moves up the post which allows liquid to flow through the hole in the valve member. Both the '620 and the '286 patented apparatuses operate in this manner.

Hakim II, at *4.

Hakim argues that the district court erred in deciding the factual issue of anticipation adversely on summary judgment; specifically, the question of whether the IT '286 reference describes a "closed position." Hakim points out that each claim of his '620 patent requires a closed position in which the valve blocks the passage of liquid, and that the IT 2286 reference describes a valve that "produces hermetic sealing," *i.e.* that blocks the passage of air. Hakim argues that a valve can be tight enough to block the passage of air but not strong enough to block the passage of liquid, and that it cannot be assumed that when the IT '286 valve is closed it blocks the passage of liquid.

The district court rejected this argument, pointing to the IT '286 statement that its purpose is to prevent liquid from flowing when suction is not applied, that is, to block the passage of liquid in the closed position. We discern no error in the district court's analysis of the description of the device

shown in the IT '286 or the operation of the valve structure. We agree with the district court that no reasonable jury could find other than that all of the limitations of the '620 claims are present in the IT '286 device, thereby anticipating the '620 invention.

C

Mr. Hakim also argues that the district court erred in failing to analyze anticipation on a claim-by-claim basis. In particular, Hakim argues that the court ignored the limitation of claim 12 that the flexible valve "begins to invert upon the application of negative pressure." It is correct that each claim must be considered separately, and that the limitations in subordinate claims are relevant to determination of anticipation of those claims by a single reference. However, the district court did discuss the aspect of when the valve begins to invert:

> Finally, Hakim argues that unlike the IT '286 device his device requires that the flexible member "invert" or "begin to invert" and he embarks on semantical gymnastics to create a distinction in the two devices. This is not, as they say, rocket science; both of these extremely simple devices are made so that, when a child sucks on the spout, the flexible member flexes up on the post, breaking the seal, and allowing the flow of liquid. It matters not whether this movement is called inverting, "beginning to invert", flexing, sliding, moving, lifting or any other term denoting its movement. Both devices allow the liquid to

> flow when suction moves the flexible diaphragm from its "sealed" position on the post.

Hakim II at *5.

Hakim does not state that this analysis is incorrect; he just asserts that this limitation was not separately addressed in the opinion. However, the "begins to invert" limitation of claim 12 was indeed discussed. Reversible error has not been shown on this ground.

We affirm the district court's conclusion that the '620 device is anticipated by the device in the IT '286 patent, and that the claims were correctly invalidated.

Hakim's Expert Declaration

Hakim argues that the district court erred in striking his declaration offered as an expert, and that his testimony provided evidence of the validity and correct interpretation of his patents. The court sustained the exclusion as follows:

> A magistrate judge's non-dispositive order is reviewable under the clearly erroneous and contrary to law standard. 28 U.S.C. § 636(b)(1)(A); Fed.R.Civ.P. 72(a); *Castillo v. Frank,* 70 F.3d 382, 385-86 (5th Cir.1995).
>
> In his Memorandum Order granting the Motion to Strike the Hakim Declaration, Magistrate Judge Kirk concluded that Hakim failed to provide a timely expert report or to

> submit himself for deposition, that expert testimony is not needed by the Court in this case, and that Hakim's testimony is self-serving, biased, and "of no assistance to the Court in understanding the 'technology' involved regarding the simple device at issue in this case."

This discretionary ruling is not grounds for reversal, for we have not been shown how the trier of fact was led into error, or could reasonably have reached a different decision had the inventor's declaration been admitted. This evidentiary ruling was in accordance with the Rules, and is affirmed.

AFFIRMED.

APPENDIX B — JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED MAY 4, 2005

(RE: '620 PATENT)

UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION

CIVIL ACTION 3-02-1371

NOURI E. HAKIM

VERSUS

CANNON AVENT GROUP, PLC, et al

May 3, 2005, Decided
May 4, 2005, Filed

JUDGES: ROBERT G. JAMES, UNITED STATES DISTRICT JUDGE. U.S. MAGISTRATE JUDGE JAMES D. KIRK.

OPINION BY: ROBERT G. JAMES

OPINION

JUDGMENT

For the reasons contained in the Report and Recommendation of the Magistrate Judge previously filed

herein, and after a de novo review of the entire record and the written objections filed herein, and concurring with the Magistrate Judge's findings under the applicable law;

IT IS ORDERED that defendant's motion for summary judgment, **Doc. # 89**, is GRANTED and plaintiff's claims as to the '620 patent are dismissed with prejudice.

THUS ORDERED AND SIGNED in Chambers at Monroe, Louisiana, on this 3 day of May 2005.

ROBERT G. JAMES

UNITED STATES DISTRICT JUDGE

APPENDIX C —JUDGMENT OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED MAY 4, 2005

(RE: '931 PATENT)

UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION

CIVIL ACTION 3-02-1371

NOURI E. HAKIM

VERSUS

CANNON AVENT GROUP, PLC, et al

May 3, 2005, Decided
May 4, 2005, Filed

JUDGES: U.S. DISTRICT JUDGE ROBERT G. JAMES. U.S. MAGISTRATE JUDGE JAMES D. KIRK.

OPINION BY: ROBERT G. JAMES

OPINION

JUDGMENT

For the reasons contained in the Report and Recommendation of the Magistrate Judge previously filed herein, and after a de novo review of the entire record and

the written objections filed herein, and concurring with the Magistrate Judge's findings under the applicable law;

IT IS ORDERED that defendant's motion for summary judgment, **Doc. # 88**, is GRANTED and plaintiff's claims as to the *'931 patent* are dismissed with prejudice.

THUS ORDERED AND SIGNED in Chambers at Monroe, Louisiana, on this 3 day of May 2005.

ROBERT G. JAMES

UNITED STATES DISTRICT JUDGE

APPENDIX D -- REPORT AND RECOMMENDATION OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED FEBRUARY 2, 2005

(RE: '620 PATENT)

UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF LOUISIANA,
MONROE DIVISION

CIVIL ACTION 3-02-1371

NOURI E. HAKIM

VERSUS

CANNON AVENT GROUP, PLC, et al

February 2, 2005, Decided
February 2, 2005, Filed

JUDGES: JAMES D. KIRK, UNITED STATES MAGISTRATE JUDGE. U.S. DISTRICT JUDGE ROBERT G. JAMES.

OPINION BY: JAMES D. KIRK

OPINION

REPORT AND RECOMMENDATION

Before the court is a motion for summary judgment, **Doc. # 89**, filed by defendants Cannon Avent Group, PLC, et al (Avent) as to U. S. Patent No. 6,357,620 ('620 patent) belonging to plaintiff, Nouri E. Hakim (Hakim). The motion

seeks a ruling that the claims of the '620 patent are invalid as not being novel in accordance with *35 U.S.C. 102(b).*

Hakim sued defendants for patent infringement claiming to be the inventor of "technology" related to children's no-spill drinking cups. Hakim claims that on March 19, 2002 he was awarded the '620 patent. Another patent was also awarded in regard to the no-spill drinking cups, Patent No. 6,321,931, which is the subject of another motion for summary judgment, Docs. # 88 in this case. Separate Reports and Recommendations are issued this date regarding those motions and the motion for summary judgment, Doc. # 90, which also concerns the '620 patent.

Defendants denied the allegations of the complaint and filed a counterclaim against Hakim asserting the invalidity of both patents on the basis of prior use of the invention, its having been the subject of prior patents, *35 U.S.C. 102,* that it was obvious, *35 U.S.C. 103,* and that it failed to contain an adequate specification, *35 U.S.C. 112.*

Law of Summary Judgment

Rule 56 of the Federal Rules of Civil Procedure mandates that a summary judgment:

> "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, [submitted concerning the motion for summary judgment], if any, show that there is no genuine

> issue as to any material fact and that the moving party is entitled to judgment as a matter of law."

Paragraph (e) of Rule 56 also provides the following:

> "When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party."

Local Rule 56.2W also provides that all material facts set forth in a statement of undisputed facts submitted by the moving party will be deemed admitted for purposes of a motion for summary judgment unless the opposing party controverts those facts by filing a short and concise statement of material facts as to which that party contends there exists a genuine issue to be tried.

A party seeking summary judgment always bears the initial burden of informing the court of the basis for its motion, and identifying those portions of the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, which it believes demonstrate the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S. Ct. 2548 at 2552, 91 L. Ed. 2d 265 (1986); *International Ass'n. of*

Machinists & Aerospace Workers, Lodge No. 2504 v. Intercontinental Mfg. Co., Inc., 812 F.2d 219, 222 (5th Cir. 1987). However, movant need not negate the elements of the non-movant's case. *Little v. Liquid Air Corporation, 37 F.3d 1069, (5th Cir. 1994).* Once this burden has been met, the non-moving party must come forward with "specific facts showing that there is a genuine issue for trial." *Izen v. Catalina,* 382 F.3d 566 (5th Cir. 2004); *Fed. R. Civ. P. 56(e).* All evidence must be considered, but the court does not make credibility determinations. If the movant fails to meet its initial burden, summary judgment should be denied. *Little,* 37 F.3d at 1075.

However, the non-movant, to avoid summary judgment as to an issue on which it would bear the burden of proof at trial, may not rest on the allegations of its pleadings but must come forward with proper summary judgment evidence sufficient to sustain a verdict in its favor on that issue. *Austin v. Will-Burt Company,* 361 F. 3d 862 (5th Cir. 2004). This burden is not satisfied with "some metaphysical doubt as to the material facts," by "conclusory allegations," by "unsubstantiated assertions," or by only a "scintilla" of evidence. *Little,* id.

Summary judgment is as appropriate in a patent case as it is in any other case. *Desper Products, Inc. v. QSound Labs, Inc.,* 157 F.3d 1325, 1332 (Fed. Cir. 1998). Thus, Avent is entitled to summary judgment of invalidity only if the facts and inferences, when viewed in the light most favorable to Hakim, would not persuade a reasonable jury to return a verdict in favor of Hakim, the non-moving party.

Appendix D

Law of Claim Construction

A court determines patent invalidity by construing the claims and then applying that construction to the accused process or product. *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 842 F.2d 1275, 1279 (Fed. Cir 1988). See also, *Business Objects, S. A. v. Microstrategy, Inc.*, 393 F.3d 1366, 2005 WL 22893 (Fed. Cir. 2005); *Markman v. Westview Instruments, Inc.*, 52 F. 3d 967, 976 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996).

Claim construction is a question of law for the court. *Markman*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384. In determining the meaning of disputed patent claim language, the court looks first to the intrinsic evidence of record examining, in order, the claim language itself, the specification, and the prosecution history. *Alza Corporation, et al v. Mylan Laboratories Inc., et al*, 391 F.3d 1365 (Fed. Cir. 2004). "Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Extrinsic evidence (e.g. reference books, expert testimony, etc.) may only be considered to enhance the court's understanding of the technology. *EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998). Extrinsic evidence may not be used to contradict the intrinsic evidence. *Mantech Envtl. Corp., v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1373 (Fed. Cir. 1998).

Appendix D

Claim terms are generally given their ordinary meaning. *Vitronics, 90 F. 3d at 1582.* Accordingly, a technical term used in a patent is interpreted as having the meaning a person "experienced in the field of the invention" would understand it to have. *Hoechst Celanese Corp. v. BP Chems. Ltd.,* 78 F.3d 1575, 1578 (Fed. Cir. 1996). A patentee may, however, act as his own lexicographer and may define a claim term differently from its ordinary meaning. Id.

A fundamental precept in claim construction jurisprudence requires construing the meaning of a claim to avoid recapture of interpretations disclaimed during prosecution of the claim before the patent office. *Omega Engineering, Inc. v. Raytek Corp.,* 334 F. 3d 1314, 1323 (Fed. Cir. 2003), *Southwall Technologies., Inc. v. Cardinal IG Co.,* 54 F. 3d 1570, 1576 (Fed Cir. 1995). The disclaimer, however must be effected with "reasonable clarity and deliberateness", *Springs Window Fashions LP v. Novo Industries, LP,* 323 F. 3d 989. 994 (Fed Cir. 2003), that is, it must be both "clear and unmistakable", *Omega Engineering, Inc.,* 334 F.3d at 1325-6. Construing a patent consistent with arguments made during its prosecution supports the public notice function of the patent record; a patentee is, therefore, held to the particular claim construction argued during patent prosecution to preserve public reliance on statements made in the public record. *Springs Window Fashions LP,* 323 F.3d at 995.

Law of Invalidity

A determination that a patent is invalid as being anticipated under *35 U.S.C. 102* requires a finding that "each

and every limitation is found either expressly or inherently in a single prior art reference." *Celeritas Techs., Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1361 (Fed. Cir. 1998). Anticipation under 102 requires "the presence in a single prior art disclosure of all elements of a claimed invention arranged as in that claim." *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d 135, 138 (Fed. Cir. 1998). Clear and convincing evidence is required to show invalidity. *WMS Gaming, Inc. v. Int'l Game Technology*, 184 F.3d 1339, 1355-56 (Fed. Cir. 1999).

Analysis

Plaintiff originally claimed violation of claim numbers 1-6, 11-15, and 20-25. However, plaintiff advised the court that he did not wish to pursue a violation of claim 25. Doc. # 95. Only claims 1,6,11,13 and 23 are "independent claims"; the rest are dependent claims, that is, they contain "a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed." *35 U.S.C. 112.*

The no-spill drinking cup apparatus described in the '620 patent and Avent's allegedly infringing product both seek to provide a method by which a small child can obtain a liquid drink by sucking on the spout of the bottle top, but when no suction is applied, the spout is blocked so that no liquid, or at least little liquid, can escape. Both products accomplish this by use of a simple valve which includes a diaphragm made of a flexible material such as silicone.

Avent asserts that Hakim's valve is invalid under *35 U.S.C. 102(b)* as being anticipated and not novel. In

support of its argument, Avent relies primarily on the intrinsic evidence regarding the patent.

The prosecution history shows that after the patent was applied for, it was denied on February 17, 2000 by the patent office, pursuant to *35 U.S.C. 102(b),* which provides, in pertinent part:

> A person shall be entitled to a patent unless
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Specifically, the patent office stated that the claims were rejected "as being clearly anticipated by the prior Belcastro patent." See Defendant's Exhibit 6.

In response to the rejection, Hakim filed a "Response", Defendants's Exhibit 6, in which he sought to distinguish the Delcastro invention. The patent office then, on November 7, 2000 rejected claims 1, 2, 5, 6, 9, and 11-17 as being clearly anticipated by Belcastro. Hakim Exh. 44, p.317,318. In May of 2001, Hakim filed an "Amendment and Response", Def. Exh 7, in which he again attempted to distinguish the prior art of Belcastro, deleted claims 1, 2, and 5 and added claims 28 and 29. The patent office then, for the second time, rejected claims 6,9,11-17, and also 28 and 29. Hakim Exh. 44, p. 330. Plaintiff then met with the patent examiner and again filed an "Amendment and Response" in which he confirmed

that agreement had been reached as to claims 6, 7, 8, 10, 16, 19, 20, and 28. Def. Exh. 8. A patent was issued. Hakim Exh. 1.

The prior patent to which defendants refer, being IT '286 was never discussed or considered during the application and prosecution process regarding patent '620.

The '620 patent claims describe an apparatus for preventing spilling during drinking. The apparatus includes a valve comprising a protruding member or post and a flexible valve member with an opening through which the protruding member extends. In the closed position (when no sucking occurs) the protruding member extending through the valve member blocks the flow of liquid. When suction is applied, the valve member "is pulled away from said protruding member for the passage of liquid through said opening". In a preferred embodiment, the post would be tapered, or conical shaped, so that the harder a child sucks, the further up the post the member moves and more liquid is allowed to flow.

The IT '286 operates in the same manner.

As mentioned earlier, the IT '286 patent was not considered by the patent office in the proceedings regarding the Hakim '620 patent.

As can be seen from the drawings, above, and the patent claims, the claims in the '620 valve apparatus and the IT '286 assembly are substantially identical in all material respects. Both inventions have a flexible valve member or diaphragm, a base and a protruding member or post, called a

peduncle in the IT '286 patent. The post extends through a hole in the valve member and, when at rest in its closed position, the valve member sits tightly around the lower portion of the post in both inventions. See Hakim Exh. 44, p. 325 and claims 23 and 25, Def. Exh 1. When a child sucks on the spout, the valve member moves up the post which allows liquid to flow through the hole in the valve member. Both the '620 and the '286 patented apparatuses operate in this manner. See Def. Exh. 2, 3.

Plaintiff attempts in brief to distinguish the patents by first suggesting that the IT patent does not disclose a no-spill drinking cup. However, as defendant correctly points out in brief, the '620 patent is for an apparatus, not a drinking cup. The IT patent is for a "valve cap applicable to the throat of a feeding bottle". "Apparatus claims cover what a device is, not what it does." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). Generally, the preamble does not limit the claims. *Allen Eng'g Corp. v. Bartell Indus., Inc.*, 299 F.3d 1336, 1346 (Fed. Cir. 2002). Further there is no meaningful difference in the "drinking cup" referred to in the preamble of the Hakim patent '620 and the "feeding bottle" referred to in the IT patent '286. The difference is one of semantics and what it is called depends more on the age of the child using the device than how it functions. Both valves operate identically.

Next Hakim suggests that the IT '286 device does not have a closed position. This assertion is baffling, for as the claims of the IT '286 suggest, and as the drawings reflect, the flexible member fits tightly around the lower portion of the post in both devices to seal off the flow of liquid. See

especially, drawing contained in IT patent at Def. Exh. 2, p. A003899 and claim 3. Plaintiff's suggestion that the IT device contains only an airtight seal and not a liquid tight seal is equally unconvincing as being directly contradicted by the IT '286 claims [see IT '286 Claim 1 ("suitable for regulating and limiting the outflow from the feeding bottle")] and the very purpose of the device. The IT valve is intended to seal the bottle when not in use. The mechanisms are the same, regardless of their intended purpose.

Next Hakim suggests that the IT '286 patent does not suggest the device can be attached to a cap as per claim 5 of his patent. To the contrary, the IT patent refers repeatedly to a "valve/cap" and the "body of the valve/cap". See also drawings at Def. Exh. 2, p. A 003899.

Finally, Hakim argues that unlike the IT '286 device his device requires that the flexible member "invert" or "begin to invert" and he embarks on semantical gymnastics to create a distinction in the two devices. This is not, as they say, rocket science; both of these extremely simple devices are made so that, when a child sucks on the spout, the flexible member flexes up on the post, breaking the seal, and allowing the flow of liquid. It matters not whether this movement is called inverting, "beginning to invert", flexing, sliding, moving, lifting or any other term denoting its movement. Both devices allow the liquid to flow when suction moves the flexible diaphragm from its "sealed" position on the post.

Appendix D

The Extrinsic Evidence

Certain extrinsic evidence has been filed by both parties in connection with this motion. That evidence consists of the affidavit of Mr. Hakim and copies of depositions, including expert deposition testimony. However, I find that consideration of the extrinsic evidence is not necessary in this case. The "technology" involved in the devices at issue is extremely simple and expert testimony is not needed to assist the court in understanding the products or the claims. *EMI Group N. Am.*, 157 F.3d at 892. Further, this court is not required to consider expert testimony when considering the defense of anticipation. The case of *Schumer v. Lab. Computer Sys., Inc.*, 308 F.3d 1304 (Fed. Cir. 2002), cited by plaintiffs does not so hold. Schumer only held that if expert testimony is heard, it must be from one skilled in the art.

Summary

Therefore, I find by clear and convincing evidence that there exists no genuine issues of material fact and that Avent is entitled to judgment as a matter of law that the '620 patent is invalid.

For the foregoing reasons, IT IS RECOMMENDED that Defendant, Avent's, Motion for Summary Judgment, Doc. # 89, be GRANTED and that plaintiff's claims as to the '620 patent be dismissed with prejudice.

Appendix D

OBJECTIONS

Under the provisions of *28 U.S.C. § 636(b)(1)(C)* and *Fed.R.Civ.P. 72(b),* the parties have ten (10) business days from service of this Report and Recommendation to file specific, written objections with the clerk of court. A party may respond to another party's objections within ten (10) days after being served with a copy thereof. A courtesy copy of any objection or response or request for extension of time shall be furnished to the district judge at the time of filing. Timely objections will be considered by the district judge before he makes his final ruling.

FAILURE TO FILE WRITTEN OBJECTIONS TO THE PROPOSED FINDINGS, CONCLUSIONS, AND RECOMMENDATIONS CONTAINED IN THIS REPORT WITHIN TEN (10) BUSINESS DAYS FROM THE DATE OF ITS SERVICE SHALL BAR AN AGGRIEVED PARTY, EXCEPT UPON GROUNDS OF PLAIN ERROR, FROM ATTACKING ON APPEAL THE UNOBJECTED-TO PROPOSED FACTUAL FINDINGS AND LEGAL CONCLUSIONS ACCEPTED BY THE DISTRICT JUDGE.

THUS DONE AND SIGNED in chambers, in Alexandria, Louisiana, on this the 2nd day of February, 2005.

JAMES D. KIRK

UNITED STATES MAGISTRATE JUDGE

APPENDIX E — REPORT AND RECOMMENDATION OFTHE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED FEBRUARY 2, 2005

(RE: '931 PATENT)

UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION

CIVIL ACTION 3-02-1371

NOURI E. HAKIM

VERSUS

CANNON AVENT GROUP, PLC, et al

February 2, 2005, Decided
February 2, 2005, Filed

JUDGES: U.S. MAGISTRATE JUDGE JAMES D. KIRK. U.S. DISTRICT JUDGE ROBERT G. JAMES.

OPINION BY: JAMES D. KIRK

OPINION

REPORT AND RECOMMENDATION

Before the court is a motion for summary judgment, **Doc. # 88**, filed by defendants Cannon Avent Group, PLC, et al (Avent) as to U. S. Patent No. 6,321,931 ('931 patent) belonging to plaintiff, Nouri E. Hakim (Hakim). The motion seeks a ruling that the claims of the '931 patent are not

infringed, or, in the alternative, are invalid as having been the subject of previous patents.

Hakim sued defendants for patent infringement claiming to be the inventor of "technology" related to children's no-spill drinking cups. Hakim claims that on November 27, 2001 he was awarded the '931 patent. Another patent was also awarded in regard to the no-spill drinking cups, Patent No. 6,357,620, which is the subject of motions for summary judgment, Docs. # 89 and 90 in this case. Separate Reports and Recommendations are issued this date regarding those motions.

Defendants denied the allegations of the complaint and filed a counterclaim against Hakim asserting the invalidity of both patents on the basis of prior use of the invention, its having been the subject of prior patents, *35 U.S.C. 102,* that it was obvious, *35 U.S.C. 103,* and that it failed to contain an adequate specification, *35 U.S.C. 112.*

The law of Summary Judgment

Rule 56 of the Federal Rules of Civil Procedure mandates that a summary judgment:

> "shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, [submitted concerning the motion for summary judgment], if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to judgment as a matter of law."

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Paragraph (e) of Rule 56 also provides the following:

> "When a motion for summary judgment is made and supported as provided in this rule, an adverse party may not rest upon the mere allegations or denials of the adverse party's pleading, but the adverse party's response, by affidavits or as otherwise provided in this rule, must set forth specific facts showing that there is a genuine issue for trial. If the adverse party does not so respond, summary judgment, if appropriate, shall be entered against the adverse party."

Local Rule 56.2W also provides that all material facts set forth in a statement of undisputed facts submitted by the moving party will be deemed admitted for purposes of a motion for summary judgment unless the opposing party controverts those facts by filing a short and concise statement of material facts as to which that party contends there exists a genuine issue to be tried.

A party seeking summary judgment always bears the initial burden of informing the court of the basis for its motion, and identifying those portions of the pleadings, depositions, answers to interrogatories, and admissions on file, together with affidavits, if any, which it believes demonstrate the absence of a genuine issue of material fact. *Celotex Corp. v. Catrett,* 477 U.S. 317, 106 S. Ct. 2548 at 2552, 91 L. Ed. 2d 265 (1986); *International Ass'n. of Machinists & Aerospace Workers, Lodge No. 2504 v. Intercontinental Mfg. Co., Inc.,* 812 F.2d 219, 222 (5th Cir. 1987). However, movant need not negate the elements of

the non-movant's case. *Little v. Liquid Air Corporation,* 37 F.3d 1069, (5th Cir. 1994). Once this burden has been met, the non-moving party must come forward with "specific facts showing that there is a genuine issue for trial." *Izen v. Catalina,* 382 F.3d 566 (5th Cir. 2004); *Fed. R. Civ. P. 56(e).* All evidence must be considered, but the court does not make credibility determinations. If the movant fails to meet its initial burden, summary judgment should be denied. *Little,* 37 F.3d at 1075.

However, the non-movant, to avoid summary judgment as to an issue on which it would bear the burden of proof at trial, may not rest on the allegations of its pleadings but must come forward with proper summary judgment evidence sufficient to sustain a verdict in its favor on that issue. *Austin v. Will-Burt Company,* 361 F. 3d 862 (5th Cir. 2004). This burden is not satisfied with "some metaphysical doubt as to the material facts," by "conclusory allegations," by "unsubstantiated assertions," or by only a "scintilla" of evidence. Little, id.

Summary judgment is as appropriate in a patent case as it is in any other case. *Desper Products, Inc. v. QSound Labs, Inc.,* 157 F.3d 1325, 1332 (Fed. Cir 1998). Thus, Avent is entitled to summary judgment of no infringement only if the facts and inferences, when viewed in the light most favorable to Hakim would not persuade a reasonable jury to return a verdict in favor of Hakim, the non-moving party.

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Procedure for Analyzing a Patent Claim

A court determines patent infringement by construing the claims and then applying that construction to the accused process or product. *Business Objects, S. A. v. Microstrategy, Inc.*, 393 F.3d 1366, 2005 WL 22893 (Fed. Cir. 2005), *Markman v. Westview Instruments, Inc.*, 52 F. 3d 967, 976 (Fed. Cir. 1995) (en banc), aff'd, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384 (1996). Claim construction is a question of law for the court. *Markman*, 517 U.S. 370, 134 L. Ed. 2d 577, 116 S. Ct. 1384. In determining the meaning of disputed patent claim language, the court looks first to the intrinsic evidence of record examining, in order, the claim language itself, the specification, and the prosecution history. *Alza Corporation, et al v. Mylan Laboratories inc., et al*, 391 F.3d 1365 (Fed. Cir. 2004). "Such intrinsic evidence is the most significant source of the legally operative meaning of disputed claim language." *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996). Extrinsic evidence (e.g. reference books, expert testimony, etc.) may only be considered to enhance the court's understanding of the technology. *EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998). Extrinsic evidence may not be used to contradict the intrinsic evidence. *Mantech Envtl. Corp., v. Hudson Envtl. Servs., Inc.*, 152 F.3d 1368, 1373 (Fed. Cir. 1998).

Claim terms are generally given their ordinary meaning. *Vitronics*, 90 F.3d at 1582. Accordingly, a technical term used in a patent is interpreted as having the meaning a person "experienced in the field of the invention" would understand it to have. *Hoechst Celanese Corp. v. BP Chems. Ltd.*,

78 F.3d 1575, 1578 (Fed. Cir. 1996). A patentee may, however, act as his own lexicographer and may define a claim term differently from its ordinary meaning. Id.

A fundamental precept in claim construction jurisprudence requires construing the meaning of a claim to avoid recapture of interpretations disclaimed during prosecution of the claim before the patent office. *Omega Engineering, Inc. v. Raytek Corp.*, 334 F. 3d 1314, 1323 (Fed. Cir. 2003), *Southwall Technologies., Inc. v. Cardinal IG Co.*, 54 F. 3d 1570, 1576 (Fed Cir. 1995). The disclaimer, however must be effected with "reasonable clarity and deliberateness", *Springs Window Fashions LP v. Novo Industries., LP,* 323 F. 3d 989, 994 (Fed Cir. 2003), that is, it must be both "clear and unmistakable", *Omega Engineering, Inc.,* 334 F.3d at 1325-6. Construing a patent consistent with arguments made during its prosecution supports the public notice function of the patent record; a patentee is, therefore, held to the particular claim construction argued during patent prosecution to preserve public reliance on statements made in the public record. *Springs Window Fashions LP,* 323 F.3d at 995.

Analysis

Plaintiff originally claimed violation of claim numbers 3,4,8,9-14,18,20,21,23, and 26. However, plaintiff advised the court that he wished to pursue a violation only of claims 3,4,9,10,13, and 14. Doc. # 95. Only claims 3 and 8 are "independent claims"; the rest are dependent claims, that is, they contain "a reference to a claim previously set forth and

then specify a further limitation of the subject matter claimed." *35 U.S.C. 112.*

The no-spill drinking cup apparatus described in the '931 patent and Avent's allegedly infringing product both seek to provide a method by which a small child can obtain a liquid drink by sucking on the spout of the bottle top, but when no suction is applied, the spout is blocked so that no liquid, or at least little liquid, can escape. Both products accomplish this by use of a simple valve which includes a diaphragm made of a flexible material such as silicone.

Avent asserts that its valve does not infringe because Hakim's patent covers a valve having two separate liquid blocking mechanisms. In support of its argument, Avent relies on the prosecution history of the patent. The court agrees that the issue of infringement in this case cannot be resolved solely by review of the claims and the specifications and that the prosecution history must also be considered. Those claims and specifications suggest only a flexible valve diaphragm which, in its resting position, seats against a "blocking element" so that liquid cannot escape but, when suction is applied, lifts away from the blocking element creating a space through which liquid can flow.

The prosecution history shows that after the patent was applied for by Hakim, it was denied on January 27, 2000 by the patent office, pursuant to *35 U.S.C. 102,* which provides, in pertinent part:

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A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Specifically, the patent office stated that the claims were rejected "as being clearly anticipated by Robbins III, et al, Bachman, et al or Belcastro. See Defendant's Exhibit 4. The three names refer to prior patents.

In response to the rejection, Hakim filed an "Amendment and Response", Defendants's Exhibit 5, in which he changed certain language in some of the claims and referred in some of the changes to the opening in the flexible valve material as being a "slit". In the "remarks" section of the Amendment and Response Hakim sought to distinguish the Robbins III, Bachman, and Belcastro inventions.

Importantly, Hakim went to great lengths to distinguish his invention emphasizing that his invention utilizes "two separate mechanisms" to close off the passage of liquid through the valve, not just one as the prior patented inventions had used. He stated:

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"This suction causes the flexible material to lift off of the blocking element, moving the slit off of that blocking element. **In addition,** since the valve material is flexible, **the flexing of the material will also stretch the slit,** facilitating the passage of liquid through the valve." (Emphasis added).

"Thus **two separate mechanisms** are both used to close off the passage of liquid through the valve when not in use. The **first** mechanism involves an inverting, flexible valve material which has a **slit** therein and responds to suction. The **second** mechanism involves the use of a **blocking element,** which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, to yet **further** prevent the passage of liquid through the valve." (Emphasis added).

Hakim further argued "by providing **both** the elastomeric member with a slit **and** a blocking element, a sealing mechanism is provided which reduces spillage **beyond that of either mechanism alone.** None of the references cited in the Office Action (Robbins III, Bachman, and Belcastro) teach or suggest such a no-spill mechanism having a slit sitting against a blocking element **such as is recited in all of the pending claims."** (Emphasis added).

He further stated "Robbins, however does not teach or suggest the use of a separate, **additional** closing element for the slit to rest against." (Emphasis added).

The prosecution history makes perfectly clear that Hakim specifically distinguished his invention from the prior art by

limiting it to an apparatus with both (1) a slit which closes when suction is not applied, and (2) a second closure consisting of a blocking element which the slit rests against.

After plaintiff's explanation, a Notice of Allowance was issued by the patent office on December 22, 2000. However, on March 21, 2001 Hakim amended the application for the patent by changing "slit" to "opening" in claims 1 and 2, which Hakim said broadened the claims. See Defendant's Exhibit 7. No new patentability arguments were presented. The '931 patent was issued. However, Hakim's amendment to add "opening" instead of "slit" did not change the requirement of his patent that the device have **two** mechanisms to stop the flow of liquid. Because Hakim did not retract any of his arguments distinguishing the prior art, he is held to the restrictive claim construction he argued during prosecution of the patent. *Springs Window,* 323 F.3d at 995.

The Avent valve utilizes only one and not two mechanisms for blocking the liquid. It, like the Hakim valve, contains a flexible diaphragm with a hole in it which diaphragm, when at rest, seats itself against a "blocking element" thus sealing off the liquid. However, the Avent valve does not have *two* mechanisms for sealing off the liquid, but only one.

In asserting that the Avent valve infringes plaintiff's patent, Hakim suggests that it is necessary for the court to interpret the term "opening" in the claims. Hakim further suggests that Avent is claiming that Hakim's patent requires

a "slit". Avent denies that it is claiming the Hakim patent requires a slit.

It is not necessary for the court to interpret "opening" or determine whether the Hakim patent requires there to be a "slit" because it is clear that what the Hakim invention and patent does require is two separate mechanisms to close off the liquid: First, a flexible diaphragm with an opening which stretches open when suction is applied but is closed when not stretched, and second, a blocking element against which the opening in the diaphragm rests.[1]

Hakim also urges the court to interpret the term "closed position". However, interpretation of that term is not necessary to the construction of the claims because, regardless of the meaning, the "Amendment and Response" makes perfectly clear that two mechanisms are required, as described above. The term "closed position" is used by Hakim both in the patent claims and in his "Amendment and Response". The term was used in its ordinary meaning but in two different contexts, and not as a term of art. *Vitronics,* 90 F.3d at 1582. According to the clear and unmistakable language used by Hakim in the "Amendment and Response"

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1 . While there is much discussion in brief by the parties about whether any "opening" other than a "slit" would accomplish the result envisioned by the patent, the court need not decide that question, for whatever kind of opening is created, it must be self-sealing based on Hakim's statements made in prosecuting the patent. For example, a T-shaped opening, an X shaped opening, or a plus sign shaped opening would work (that is they would open when stretched and close when at rest): whether those are considered "slits" or just "openings" is beside the point.

the patent requires "flexible" or "elastomeric" valve material which, when flexed, will "stretch the slit [or opening or orifice or hole]". In its resting position, "**the slit is not being stretched and is in a closed position**." Clearly, the term "closed position" here means that the slit is not stretched into an open position. Otherwise, this would not constitute a second mechanism for stopping the flow of liquid. Equally clear is the meaning as used in the claims, where it is stated in claim 3, for example, that the valve has a closed position and an open position where the "valve member sits against a blocking element with said opening against said blocking element when in said closed position **such that said blocking element blocks** the passage of fluid. . . ." (Emphasis added). It is obvious that, when at rest, both mechanisms are in their closed position, that is, the slit is not stretched open and the slit is "sealed" against the blocking element.

Hakim's arguments, through counsel, are at best disingenuous, for he clearly stated in prosecution of the patent: "In addition, since the valve material is flexible, the flexing of the material will **also** stretch the slit, facilitating the passage of liquid through the valve." Further, counsel's suggestion that the prosecution language merely "mentions" two mechanisms and that the two mechanisms are (1) the flexible valve material and (2) the blocking element is equally specious. For Hakim made clear in the prosecution language at p. 7, in order to obtain the patent, that the two mechanisms are (1) the slit in the flexible valve material which, when suction is applied, opens to allow the flow of liquid, and the seating of the slit against the blocking element.

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Hakim's statements were clear and were deliberate, having been made specifically to convince the patent office to grant the patent after it had initially been denied. The impossibility of counsel's argument is further shown by Hakim's statement that "by providing **both** the elastomeric member with a slit **and** a blocking element, a sealing mechanism is provided which reduces spillage **beyond that of either mechanism alone.**" If the "blocking element" is, as counsel suggests, one of the two mechanisms, how could it "alone" possibly stop the flow of liquid?

Now that the scope of the claims has been determined, it is necessary to determine whether the Avent valve infringes those claims. I find by clear and convincing evidence that the Avent product does not infringe Hakim patent '931. The simple fact is that, unlike Hakim's patent, the Avent product does not contain two mechanisms of any kind to stop the flow of liquid. Rather, the Avent product uses a basic design which, although modified, has been well known since at least as early as 1959. See discussion below. Further, the diaphragm in Avent's valve does not independently block fluid flow. The only blocking mechanism in the Avent valve is the action of the diaphragm sitting against the blocking element and "sealing" off the flow of liquid.

Otherwise the Hakim Patent is Invalid

Were the court not to construe the patent in this manner, then the invalidity of the Hakim patent '931 is assured. For Hakim's patent would be no more than a duplication of the prior art, which is why it was rejected by the patent office in the first place. The concept of a flexible diaphragm with a

hole [2] in it which rests against a blocking element to shut off the flow of liquid when pressure (sucking) is not applied, has been known since at least 1959 and is the subject of at least four patents. *35 U.S.C. 102(b).* The first is the EP '828 European patent, the second is the IT '286 Italian patent, the third is the Robbins III U. S. patent, copies of which appear at Defendants' Exhibits 2, 3, and 15, respectively, and the fourth is the Belcastro patent cited by the patent office in its initial denial of the patent which appears at Def's Exh. 5 filed in connection with the Motion for Summary Judgment regarding the '620 patent, Doc. # 89. Whether the patent also offends the Bachman patent cited by the patent office, is unknown; a copy of that patent does not appear of record. Had Hakim not differentiated his invention by insisting that it involved two mechanisms, not just one, he would have had no patent at all. However, because the '931 patent requires two mechanisms, it is not necessary to find the Hakim '931 patent invalid as being no invention and anticipated by the prior art.

The Extrinsic Evidence

Certain extrinsic evidence has been filed by both parties in connection with this motion. That evidence consists of the affidavit of Mr. Hakim and copies of depositions, including expert deposition testimony. However, I find that consideration of the extrinsic evidence is not necessary in this case. The "technology" involved in the devices at issue is extremely simple and expert testimony is not needed to assist the court in understanding the products or the claims. *EMI Group N. Am.*, 157 F.3d at 892.

2. Call it what you want.

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Summary

Therefore, I find that there exists no genuine issue of material fact and that Avent is entitled to judgment as a matter of law that the Avent patent does not infringe any of the claims 3, 4, 8, 9, 10, 11, 12, 13, 14, 18, 20, 21, 23, or 26 [3] of the Hakim '931 patent.

For the foregoing reasons, IT IS RECOMMENDED that Defendant, Avent's, Motion for Summary Judgment, Doc. # 88, be GRANTED and that plaintiff's claims as to the '931 patent be dismissed with prejudice.

OBJECTIONS

Under the provisions of *28 U.S.C. § 636(b)(1)(C)* and *Fed.R.Civ.P. 72(b),* the parties have ten (10) business days from service of this Report and Recommendation to file specific, written objections with the clerk of court. A party may respond to another party's objections within ten (10) days after being served with a copy thereof. A courtesy copy of any objection or response or request for extension of time shall be furnished to the district judge at the time of filing. Timely objections will be considered by the district judge before he makes his final ruling.

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3. None of these claims have been dismissed by the court and are now before the court for consideration on this motion. Judicial efficiency requires that all of the claims in the patent be considered now.

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FAILURE TO FILE WRITTEN OBJECTIONS TO THE PROPOSED FINDINGS, CONCLUSIONS, AND RECOM MENDATIONS CONTAINED IN THIS REPORT WITHIN TEN (10) BUSINESS DAYS FROM THE DATE OF ITS SERVICE SHALL BAR AN AGGRIEVED PARTY, EXCEPT UPON GROUNDS OF PLAIN ERROR, FROM ATTACKING ON APPEAL THE UNOBJECTED-TO PROPOSED FACTUAL FINDINGS AND LEGAL CONCLUSIONS ACCEPTED BY THE DISTRICT JUDGE.

THUS DONE AND SIGNED in chambers, in Alexandria, Louisiana, on tnis the 2nd day of February, 2005.

JAMES D. KIRK

UNITED STATES MAGISTRATE JUDGE

APPENDIX F — ORDER OF THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT DENYING PETITION FOR REHEARING FILED MAY 2, 2007

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

05-1398

NOURI E. HAKIM

Plaintiff-Appellant

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED and AVENT AMERICA, INC.,

Defendants-Appellees.

May 2, 2007, Decided
May 2, 2007, Filed

OPINION

ORDER

A combined petition for panel rehearing and for rehearing en banc having been filed by the Appellant, and a response thereto having been invited by the court and filed by the Appellees, and the petition for rehearing and response, having been referred to the panel that heard the appeal, and thereafter

the petition for rehearing en banc and response having been referred to the circuit judges who are in regular active service,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for panel rehearing be, and the same hereby is, DENIED and it is further

ORDERED that the petition for rehearing en banc be, and the same hereby is, DENIED.

The mandate of the court will issue on May 9, 2007.

APPENDIX G — U.S. PATENT NO. 6357620 (EXCERPTED)

United States Patent **6,357,620**

Hakim **March 19, 2002**

No-spill drinking cup apparatus

Abstract

An improved no-spill cup construction and valve assembly which provides an extremely secure seal against accidental liquid flow from the cup spout. The act of sucking at the cup spout creates negative pressure or a partial vacuum against a valve member near the spout having an opening therein, causing the valve member and opening to move off of a protruding member, thereby unblocking the opening in the valve. When the opening is unblocked, liquid can flow freely through the valve and spout. When not in use, the valve sits in a resting, closed position, with the opening in the valve sitting on a protruding member and pressed against the protruding member's base, sealing off the opening in the valve assembly. The closed position provides an extremely secure seal against fluid leakage, such that inadvertent spills or even deliberate attempts to force liquid outside of the cup, such as by turning the cup upside down, or shaking the cup, are ineffective. The cup assembly further allows variable liquid flow depending on the levels of suction applied, and allows flow to be regulated between regular or maximum flow and minimal flow levels or rates by rotating the position of the valve assembly in the cover of the cup.

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Claims

I claim:

1. An apparatus for preventing spilling during drinking, said apparatus comprising:

a valve, said valve comprising a protruding member and a valve member, said valve member comprising an opening, said valve having a closed position and in an open position,

said closed position being a configuration in which said protruding member extends through said opening of said valve member to block the passage of liquid through said opening,

said valve further being movable into an open position in which said valve member is pulled away from said protruding member for the passage of liquid through said opening,

said valve moving from said closed position to said open position upon the application of negative pressure to said valve member.

2. An apparatus as claimed in claim 1, wherein said apparatus comprises a cap for a cup.

3. An apparatus as claimed in claim 1, wherein said apparatus comprises a drinking cup.

4. An apparatus as claimed in claim 1, wherein said apparatus comprises a valve assembly.

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5. An apparatus as claimed in claim 1, wherein said apparatus comprises a valve assembly and a cap, said valve being a part of said valve assembly, said valve assembly and cap being configured such that said valve assembly can be attached to said cap.

6. An apparatus as claimed in claim 1, further comprising a sealing member, said sealing member comprising said protruding member and a base, said protruding member being attached to said base.

7. An apparatus as claimed in claim 6, herein said base is approximately flat.

8. An apparatus as claimed in claim 6, wherein said protruding member is a post.

9. An apparatus as claimed in claim 6, wherein said protruding member is conical.

10. An apparatus as claimed in claim 6, wherein at least a portion of said post is tapered.

11. A no spill drinking apparatus, comprising:

a valve, said valve comprising a sealing member and a flexible valve member, said sealing member comprising a protruding member and a base, said valve member comprising an opening therein;

said valve having a closed position, said closed position being a configuration in which said valve member rests proximal

to said base with said protruding member extending through said opening, to block the passage of liquid through said opening;

wherein said valve moves into an open position upon application of negative pressure to said valve, said open position being a position in which said valve member is distal to said base, with said opening at least partially unblocked, to allow the passage of liquid through said valve.

12. An apparatus as claimed in claim 11, wherein said valve rests in said closed position, and begins to invert upon the application of negative pressure to said valve member, to move from said closed position to said open position.

13. A no spill drinking apparatus, comprising:

a valve, said valve comprising a sealing member and a valve member, said sealing member comprising a protruding member and a base, said valve member comprising a substantially circular opening therein, said protruding member having an upper portion and a lower portion;

said upper portion being of smaller diameter than said lower portion;

said valve having a closed position and in an open position, said closed position being a configuration in which said valve member rests proximal to said base with said protruding member extending through said opening to block the passage of liquid through said opening;

said valve moving into an open position upon the application of negative pressure to said opening by the mouth of a user for the purpose of drinking out of said apparatus, said open position being a position in which said valve member moves distal to said base to separate away from said opening, such that said opening is at least partially unblocked to allow the passage of liquid through said opening and said valve.

14. An apparatus as claimed in claim 13, wherein said apparatus comprises a cap for a cup.

15. An apparatus as claimed in claim 13, wherein said apparatus comprises a drinking cup.

16. An apparatus as claimed in claim 13, wherein said apparatus comprises a valve assembly.

17. An apparatus as claimed in claim 13, wherein said protruding member is tapered.

18. An apparatus as claimed in claim 13, wherein at least a portion of said protruding member is tapered at an angle of seven (7) degrees.

19. An apparatus as claimed in claim 13, wherein at least a portion of said protruding member is tapered at an angle of nine (9) degrees.

20. An apparatus as claimed in claim 13, wherein said protruding member extends through and beyond said opening in said closed position.

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21. An apparatus as claimed in claim 13, wherein said apparatus further comprises an anti-inversion member, said anti-inversion member being placed at a sufficiently close distance to such valve member such that such valve member will hit said anti-inversion member and be blocked from further inversion before said valve member fully inverts.

22. An apparatus as claimed in claim 13, wherein said valve member comprises a flexible material.

23. A no spill drinking apparatus, comprising:

a valve, said valve comprising a sealing member and a flexible valve member, said sealing member comprising a protruding member and a base, said valve member comprising an opening therein;

said valve having a closed position and an open position, wherein at least a portion of said sealing member extends through said opening while said valve is in said closed position, said valve member resting closer to said base in said closed position than in said open position; and,

wherein said protruding member of said valve is fixed, and said valve member moves upon application of negative pressure to said valve member.

24. An apparatus as claimed in claim 23, wherein said valve member moves away from said base upon the application of negative pressure to said valve.

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25. A no spill drinking apparatus, comprising:

a valve, said valve comprising a post and a base, said valve further comprising a flexible valve member having a hole;

said valve having a closed position and an open position, wherein said post extends through said hole while said valve is in said closed position, and wherein said flexible valve member rests closer to said base in said closed position than in said open position; and,

wherein said post of said valve is fixed and said flexible valve member moves away from said base upon application of negative pressure to said valve member.

APPENDIX H — U.S. PATENT NO. 6321931 (EXCERPTED)

United States Patent **6,321,931**

***Hakim*, et al.** **November 27, 2001**

No-spill drinking cup apparatus

Abstract

An improved no-spill cup construction and valve assembly which provides an extremely secure seal against accidental liquid flow from the cup spout. The act of sucking at the cup spout creates negative pressure or a partial vacuum against a valve near the spout, causing the valve to invert which unblocks an opening in the valve. When the opening is unblocked, liquid can flow freely through the valve and spout. When not in use, the valve sits in a resting, closed position, with the valve pressed against a center seal-off, sealing off the opening in the valve assembly. The closed position provides an extremely secure seal against fluid leakage, such that inadvertent spills or even deliberate attempts to force liquid outside of the cup, such as by turning the cup upside down, or shaking the cup, are ineffective. The cup assembly further allows liquid flow to be regulated between regular or maximum flow and minimal flow levels or rates by rotating the position of the valve assembly in the cover of the cup.

Appendix H

Description

FIELD OF THE INVENTION

The present invention relates to a no-spill cup assembly with an improved valve mechanism to prevent liquid from flowing out of the cup when not desired.

. . .

DETAILED DESCRIPTION OF THE INVENTION AND THE PREFERRED EMBODIMENTS

. . .

Any form of desired opening suitable for passage of a desired level of liquid can be utilized in the valve. The opening 70 can be, for example, a slit, a slot, an orifice, a hole, or so forth. Likewise, by the term opening, it is contemplated that multiple openings of these or any other types can be provided as well.

. . .

Claims

. . .

1. An apparatus for use in a no-spill drinking cup, said apparatus comprising:

a valve holder, such valve holder comprising at least one valve and a blocking element, said valve comprising a flexible material, said blocking element comprising an area

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of material which is impenetrable to the flow of liquid, said valve further comprising an opening through said flexible material, said valve having a resting position wherein said flexible material sits with said opening against said blocking element such that said valve is closed to the passage of liquid through said valve, said valve moving into an open position for the passage of liquid through said valve upon the application of negative air pressure to the top of said valve, said open position being a position wherein said flexible member comprising said opening lifts off of said blocking element.

2. An apparatus as claimed in claim 1, further comprising a cover, said valve holder being located in said cover, and a cup, said cover being adapted to attach to said cup.

3. An apparatus for use in a no-spill drinking cup, comprising:

a flexible valve member comprising an opening through said valve member, said valve member having a closed position and an open position, wherein said valve member sits against a blocking element with said opening against said blocking element when in said closed position such that said blocking element blocks the passage of fluid through said opening in said valve member, and wherein said valve member moves away from said blocking element to allow passage of liquid though said opening of said valve member upon application of negative air pressure to said valve member.

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4. An apparatus as claimed in claim 3, further comprising a cover, said flexible valve member being located in said cover, and a cup, said cover being adapted to attach to said cup.

5. A no-spill cup apparatus, comprising:

a flexible valve member comprising an opening in said valve member, said flexible member having a proximal side and a distal side; and

a blocking element, said blocking element comprising a first area which is impenetrable to the flow of liquid, and a second area through which liquid can flow, said distal side of said flexible valve member resting against said blocking element when said flexible valve member is in the resting, closed position such that said opening of said flexible valve member rests against said first area when said flexible valve member is in said resting, closed position, said flexible valve member backing off said blocking element upon the application of negative air pressure to said proximal side of said flexible valve member to allow fluid to flow through said second area of said blocking element and through said opening of said flexible valve member.

6. An apparatus as claimed in claim 5, wherein said opening comprises a slit.

7. An apparatus as claimed in claim 5, wherein said first area is the central area of said blocking element, and wherein said second area is the peripheral area of said blocking element.

Appendix H

8. A no-spill drinking cup apparatus, comprising:

a flexible valve member, said flexible valve member having an opening therein; and,

a blocking element said flexible valve member resting against said blocking element when said valve member is in its closed position such that said opening sits against said blocking element to block the passage of liquid through said opening.

9. An apparatus as claimed in claim 8, said flexible valve member further comprising an open position, said flexible valve member being displaced away from said blocking element in said open position to provide liquid access to said opening, said flexible member assuming said open position upon application of negative air pressure to the top of said valve member.

10. An apparatus as claimed in claim 9, wherein said flexible valve member inverts upon application of negative air pressure to said valve member to move said opening away from said blocking element.

11. An apparatus as claimed in claim 8, wherein said flexible valve member is located in a valve assembly.

12. An apparatus as claimed in claim 11, wherein said valve assembly comprises at least one subunit for containing said valve member.

13. An apparatus as claimed in claim 12, wherein said valve assembly comprises at least two subunits, each of said subunits comprising a valve member therein.

Appendix H

14. An apparatus as claimed in claim 12, wherein said valve assembly comprises at least two subunits, a first subunit comprising a first valve member comprising a first opening, and a second subunit comprising a second valve member comprising a second opening, said first opening being larger than said second opening.

15. An assembly as claimed in claim 14, wherein said first opening is an "X" shaped slot.

16. An assembly as claimed in claim 14, wherein said second opening is a "T" shaped slot.

17. An assembly as claimed in claim 14, wherein said first opening is an "X" shaped slot and said second opening is a "T" shaped slot.

18. An assembly as claimed in claim 8, wherein said assembly further comprises a removable cap.

19. An assembly as claimed in claim 8, wherein said cap comprises a valve assembly carrier for securing said valve assembly to said cap.

20. An assembly as claimed in claim 18, further comprising a cup for attachment to said removable cap.

21. An assembly as claimed in claim 20, wherein said cap is provided with screw threads for screwing onto said cup.

22. An assembly as claimed in claim 20, wherein said cap is a snap-on cap, for attachment to said cup.

Appendix H

23. An apparatus as claimed in claim 12, wherein said blocking element is located in said subunit.

24. An apparatus as claimed in claim 23, wherein said blocking element comprises a solid central area impenetrable to liquid flow, and a peripheral region surrounding said central area, said peripheral region having at least one area open to the passage of liquid.

25. An apparatus as claimed in claim 24, wherein said opening rests against said central region when said valve member is in its closed position.

26. An apparatus as claimed in claim 23, wherein said subunit comprises a valve retainer for securing said flexible valve member in said subunit.

27. An apparatus as claimed in claim 8, wherein said opening comprises a slit.

28. An apparatus as claimed in claim 1, wherein said opening is a slit.

29. An apparatus as claimed in claim 3, wherein said opening is a slit.

APPENDIX I — RULING OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED MAY 4, 2005

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF LOUISIANA
MONROE DIVISION

No. 02-1371

NOURI E. HAKIM,

v.

CANNON AVENT GROUP, PLC, *et al.*

May 3, 2005, Decided
May 4, 2005, Filed

RULING

On February 2, 2005, Magistrate Judge James D. Kirk issued a Memorandum Order [Doc. No. 124] granting Defendants' Motion to Strike the Hakim Declaration [Doc. No. 108]. On February 22, 2005, Plaintiff filed a document entitled "Plaintiff's Objection to Magistrate Judge's Report and Recommendation [sic] that the Hakim Declaration Be Stricken," which the Court construes as an appeal [Doc. No. 128] of the Magistrate Judge's February 2, 2005 Memorandum Order. On March 9, 2005, Defendants filed a Response to Plaintiff's Request for Review of the Magistrate Judge's Memorandum Order.

Appendix I

For the following reasons, the Magistrate Judge's February 2, 2005 Memorandum Order [Doc. No. 124] is AFFIRMED, and Plaintiff's appeal [Doc. No. 128] is DENIED.

A magistrate judge's non-dispositive order is reviewable under the clearly erroneous and contrary to law standard. 28 U.S.C. § 636(b)(1)(A); Fed.R.Civ.P. 72(a); *Castillo v. Frank*, 70 F.3d 382, 385-86 (5th Cir.1995).

In his Memorandum Order granting the Motion to Strike the Hakim Declaration, Magistrate Judge Kirk concluded that Hakim failed to provide a timely expert report or to submit himself for deposition, that expert testimony is not needed by the Court in this case, and that Hakim's testimony is self-serving, biased, and "of no assistance to the [C]ourt in understanding the 'technology' involved regarding the simple device at issue in this case."

In patent infringement suits, the Federal Circuit has admonished that "claims should preferably be interpreted without recourse to extrinsic evidence such as expert testimony . . . and that expert testimony should be received only for the purpose of educating the judge." *EMI Group North America, Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed.Cir.1998). "In most situations, an analysis of the intrinsic evidence alone will resolve any ambiguity in a disputed claim term. In such circumstances, it is improper to rely on extrinsic evidence." *C.P. Partnership v. Far West Products*, Civ. No. 6:97-1337, 1998 WL 998960 (W.D.La. Aug. 25, 1998) (citing *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed.Cir.1996)). "In construing the claims

we look to the language of the claims, the specification, and the prosecution history. Extrinsic evidence *may* also be considered, *if needed* to assist in determining the meaning or scope of technical terms in the claims." *Pall Corp. v. Micron Separations, Inc.* 66 F.3d 1211, 1216 (Fed.Cir.1995) (emphasis added; citations omitted).

In the present case, Magistrate Judge Kirk determined that the consideration of extrinsic evidence such as the Hakim Declaration was not necessary to assist in construing the claims because the technology involved is relatively simple.

Having conducted a review of the entire record, including the memoranda submitted by Defendants and Plaintiff, the Court finds that, under the facts and circumstances of this case, the Magistrate Judge's ruling was not clearly erroneous or contrary to the law.

IT IS HEREBY ORDERED that Plaintiff's appeal [Doc. No. 128] is DENIED and the Magistrate Judge's February 2, 2005 Memorandum Order [Doc. No. 124] granting Defendants' Motion to Strike the Hakim Declaration is AFFIRMED.

MONROE, LOUISIANA, this 3 day of May, 2005.

ROBERT G. JAMES

UNITED STATES DISTRICT JUDGE

APPENDIX J — MEMORANDUM ORDER OF THE UNITED STATES DISTRICT COURT FOR THE WESTERN DISTRICT OF LOUISIANA, MONROE DIVISION FILED FEBRUARY 2, 2005

UNITED STATES DISTRICT COURT
WESTERN DISTRICT OF LOUISIANA
MONROE DIVISION

No. 02-1371

NOURI E. HAKIM,

v.

CANNON AVENT GROUP, PLC, *et al.*

February 2, 2005, Decided
February 2, 2005, Filed

MEMORANDUM ORDER

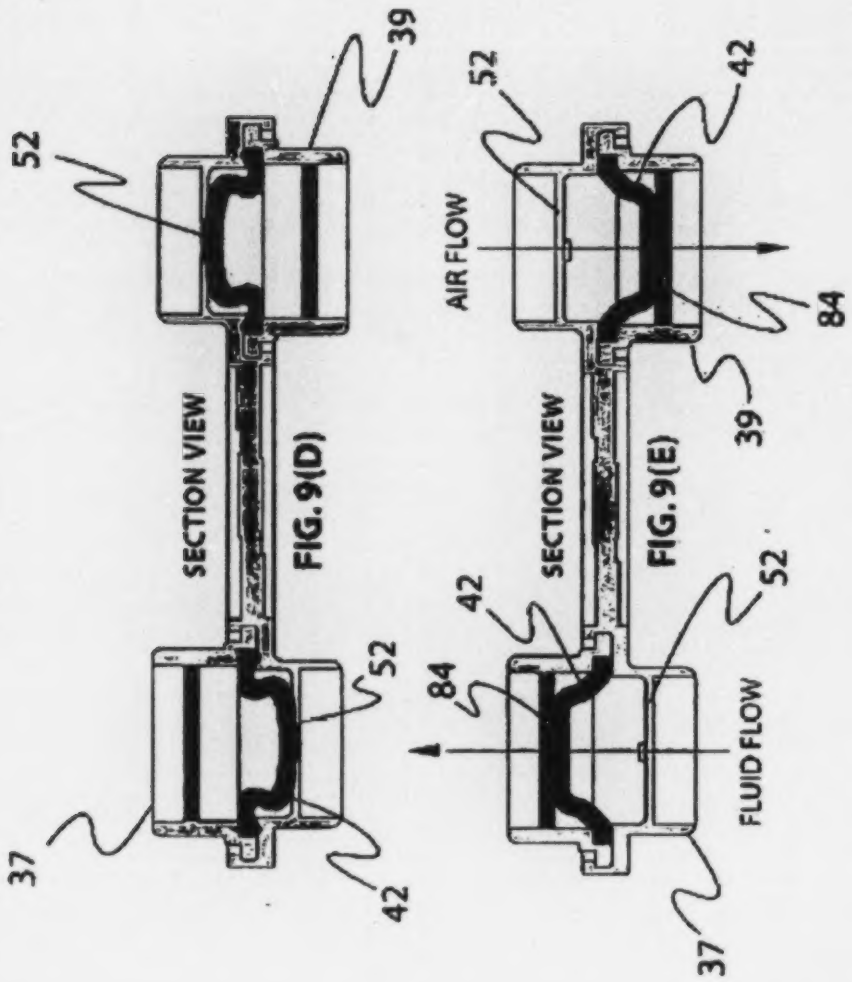
Before the court is defendant's motion to strike, Doc. # 108 the affidavit testimony of plaintiff in regard to the motions for summary judgment, Docs. # 88, 89, and 90, now before the court. Plaintiff, Hakim, has filed the affidavit in opposition to defendants' motions. Defendants move to strike because plaintiff was not designated as an expert witness and has failed to comply with the court's rules and with the FRCP requiring expert reports.

The motion is GRANTED.

Appendix J

Hakim, while identifying himself as a potential witness who would give expert testimony, failed to provide a timely expert report or to submit himself to deposition. Further, as noted in the Reports and Recommendations concerning Doc. # 88 and 89, expert testimony is not needed by the court in this case. Hakim's testimony is self serving and, because he is a party is biased and of no assistance to the court in understanding the "technology" involved regarding the simple device at issue in this case. See FRE 701, 702 and this court's scheduling order issue in this case.

APPENDIX K — ILLUSTRATION OF FIGURES 9(D) AND 9(E) FROM '931 AND '620 PATENTS



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(2)

FILED

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No. 07-150

IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, *et al.*,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE
UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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QUESTIONS PRESENTED

1. Whether Petitioner has presented compelling reasons to grant the Petition where the Federal Circuit affirmed the district court's application of the doctrine of prosecution disclaimer so as to limit the scope of the patentee's invention consistent with his clear, unmistakable and unretracted statements to the Patent Office?

2. Whether Petitioner has presented compelling reasons to grant the Petition where the Federal Circuit affirmed the district court's claim construction based upon the intrinsic evidence?

PARTIES TO THE PROCEEDING

The full name of every party represented by us is: Avent Group Limited (f/k/a Cannon Avent Group PLC) Avent Limited (f/k/a Cannon Rubber Limited) Avent America, Inc.

CORPORATE DISCLOSURE STATEMENT

The respondents are Avent Group Limited (f/k/a Cannon Avent Group PLC), Avent Limited (f/k/a Cannon Rubber Limited) and Avent America, Inc.

All parent corporations and any publicly held companies that own 10 percent or more of the stock of any reaspondent are:

Avent Group Limited (f/k/a Cannon Avent Group PLC) is the parent company of Avent Limited (f/k/a Cannon Rubber Limited) and Avent America, Inc.

Avent Finance Limited is the parent company of Avent Group Limited (f/k/a Cannon Avent Group PLC).

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INTRODUCTION

Petitioner has presented *no* "compelling reasons" that warrant the grant of his Petition for a Writ of Certiorari. *See* Sup. Ct. R. 10.

Contrary to Petitioner's assertions, the Federal Circuit did *not* proclaim a "new rule of prosecution disclaimer." Nor did it issue any holding contrary to this Court's precedent. Indeed, the very premises of the Petition, as set forth in Petitioner's Questions Presented, are based on misstatements of fact and law.

First, the Federal Circuit most certainly did *not* read a limitation back into an issued patent claim after removal of that limitation during prosecution. The fact is that the limitation in question was *never* removed.

As the Federal Circuit explicitly noted, the patentee unequivocally represented to the United States Patent and Trademark Office ("PTO") that his claimed invention was patentable over the prior art because his invention provides two separate sealing mechanisms to close off the passage of fluid — a flexible valve member with a slit that opens or closes depending on whether suction is applied or not, and a blocking element on which the slit sits to further block liquid flow. *See* Appendix A[1] at 3a-4a. Significantly, at the time these distinguishing arguments were made, thirteen of the nineteen pending claims recited "opening"; only six of the pending claims recited "slit."

---

[1] Citations to Appendix A refer to the appendix provided in Petitioner's brief.

Thus, as the Federal Circuit recognized, the limitation in question applied to claims that recited "opening" as well as those that recited "slit":

> . . . during prosecution the presence of the slit in the flexible valve material was emphasized as distinguishing *all* of the claims from the cited references.

See Appendix A at 4a (emphasis added).

The patentee's later amendment to change some of the allowed claims to recite "opening" instead of "slit," did not broaden or change the meaning of "opening" because the patentee's previous disclaimer applied to claims that recited "opening." Thus, the patentee did *not* remove from the claims the limitation the patentee had argued for patentability, namely, that the claimed "opening" operates as a slit to provide the required two separate sealing mechanisms.

Moreover, in amending some claims to substitute the term "opening" for "slit," the patentee did *not* disavow his previous disclaiming arguments. Instead, he expressly adopted and relied upon his earlier prosecution arguments to obtain allowance of the amended claims.

In affirming the district court's holding that prosecution disclaimer limited the scope of the patentee's claims the Federal Circuit did not proclaim any new law, but explicitly followed the well established precedent of this Court. *See* Appendix A at 8a.

Petitioner's second premise for its Petition, namely that the Federal Circuit supposedly held that claim construction

and patent validity rulings can be entered without reliance on the evidentiary underpinnings required by this Court's precedent, also has no basis in law or fact.

Contrary to Petitioner's assertions, the Federal Circuit did *not* hold that claim construction regarding *disputed* terms may "not be necessary." *See* Petition at 3. Rather, the Federal Circuit explained that claims need only be construed to the extent required to resolve the parties' dispute. Specifically, the Federal Circuit held that:

> Claim construction is directed to claims or claim terms whose meaning is disputed as applied to the patentee's invention in the context of the accused device. *When there is no dispute as to the meaning of a term that could affect the disputed issues of the litigation, "construction" may not be necessary.*

See Appendix A at 11a (emphasis added).

And as to the disputed claim terms, the Federal Circuit went on to reject Petitioner's construction of "closed position" as well as Petitioner's argument that the district court had failed to address the claim terms "begins to invert." *See* Appendix A at 12a-14a. Indeed, the Federal Circuit actually quoted from the district court's analysis of that claim term. *See* Appendix A at 14a. Petitioner's "evidence" for a contrary meaning of "invert" was expressly excluded by the district court because the "evidence" comprised merely conclusory statements contained in Petitioner's own "expert" declaration submitted late, after the close of expert discovery. The Federal Circuit held that the district court properly excluded Petitioner's declaration. *See* Appendix A at 14a.

The bottom line is that the Federal Circuit and district court fully considered and correctly decided each of the issues Petitioner raises. And in doing so, the courts below followed well-established precedent of this Court. There is simply no basis for the grant of certiorari here.[2]

STATEMENT OF THE CASE

In this case, the Petitioner alleged infringement of two patents — U.S. Patent No. 6,321,931 (the "'931 patent") and U.S. Patent No. 6,357,620 (the "'620 patent"). Both patents are entitled: "No-Spill Drinking Cup Apparatus" and are related to a rather simple device — a sippy cup.

After close of expert discovery, the district court entered summary judgment that the '931 patent is not infringed, and that the claims of the '620 patent are invalid.

On February 23, 2007, the Federal Circuit affirmed and on May 2, 2007 the Federal Circuit denied Petitioner's combined petition for panel rehearing and rehearing en banc.

---

[2] It should be noted that the Federal Circuit denied Petitioner's Petition for Panel Rehearing and Rehearing en banc. Fed. R. App. P. 40(a)(2) requires that a petition for panel rehearing state with particularity each point of law or fact that the petitioner believes the court has overlooked or misapprehended. A panel rehearing petition is not to be used merely to reiterate arguments previously rejected by the court. *See* 2A Fed. Proc., L. Ed. § 3:926 (2006); *see also United States v. Molina-Tarazon*, 285 F.3d 807, 808 (9th Cir. 2002). Rehearing en banc "is not favored and ordinarily will not be ordered unless" it is necessary to ensure uniformity of the court's precedent or the proceeding "involves a question of exceptional importance." Fed. R. App. P. 35(a).

In issuing and affirming judgment of non-infringement of the '931 patent, the courts below relied on the clear and unambiguous statements the patentee made to the PTO to obtain patent allowance. Specifically, after the PTO rejected all of the pending application claims as being "clearly anticipated" by the prior art (*see* A0218-A0220)[3], the patentee distinguished his claimed invention by repeatedly arguing that his invention required "two separate mechanisms" to block liquid flow out of the cup. *See* A0222-A0230. The patentee explained that one of those closure mechanisms is a flexible valve member having a slit that independently blocks fluid flow and that the other mechanism is a blocking element, which presses against the slit to *further* block fluid flow:

> When a person drinks from a cup constructed in accordance with the invention, suction (negative air pressure) is applied to the flexible valve material. This suction causes the flexible material to lift off of the blocking elements, moving the *slit* off of that blocking element. *In addition, since the valve material is flexible, the flexing of the material will also stretch the slit, facilitating the passage of liquid through the valve.*
>
> When a person finishes drinking or when the cup sits on a table, no suction is being applied to the valve. During this time, the flexible valve sits with the slit against the blocking element. In addition, *the slit is not being stretched and is in a closed position.*

---

[3] Citations to Axxxx refer to the joint appendix provided to the Federal Circuit in the record below.

> *Thus, two separate mechanisms are both used to close off the passage of liquid through the valve when not in use.* The first mechanism involves an inverting, flexible valve material which has *a slit* therein and responds to suction. The second mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, *to yet further prevent the passage of liquid through the valve.*

See A0227-A0228 (emphasis added).

To further distinguish his claimed invention over the prior art, the patentee emphasized that the additional sealing provided by the blocking element reinforces the independent ability of the valve member's slit to block liquid flow:

> By providing both the elastomeric member with *a slit* and a blocking element, a sealing mechanism is provided which reduces spillage *beyond that of either mechanism alone.*

See A0228 (emphasis added).

While most of the rejected application claims recited an "opening" as opposed to a "slit," (*see* A0252-A0258 (original application claims 1-30)), the patentee indisputably relied on the special characteristics of a "slit" (*i.e.*, normally-closed when unstretched) to distinguish "*all* of the pending claims" from the prior art:

> None of the references cited in the Office Action teach or suggest such a no-spill mechanism having

> *a slit* sitting against a blocking element *such as is recited in all of the pending claims.*

See A0228 (emphasis added).

Based on these arguments, the PTO allowed all of the pending application claims—both those referring to an "opening" and those referring to a "slit."

Following such allowance, however, the patentee continued the prosecution of his patent application. *See* A0260-A0268. He amended two of the previously allowed claims that recited a "slit" by changing the word "slit" to "opening." *See* A0266-A0267. In doing so, however, the patentee presented *no* new patentability arguments. Instead, he expressly relied on his previous arguments concerning the importance of a slit-like "opening." *See* A0264. On that basis, the '931 patent was issued.

REASONS FOR DENYING THE PETITION

1. The Federal Circuit's Ruling Of Prosecution Disclaimer Follows The Well Established Precedent Of This Court

Contrary to Petitioner's assertions, the Federal Circuit did *not* proclaim a "new rule of prosecution history disclaimer" that is contrary to this Court's precedent. Moreover, the very premise for Petitioner's argument — that the Federal Circuit supposedly read back into the claims of the '931 patent a limitation that was removed during prosecution — is simply not true.

As the Federal Circuit correctly noted, to overcome a prior art rejection by the PTO, the patentee distinguished his invention from the cited prior art on the basis that his invention requires two separate closure mechanisms to block the flow of fluid. One mechanism consists of a *"flexible valve material which has a slit." See* Appendix A at 3a (emphasis in original). The other mechanism involves the use of a "blocking element, which is impenetrable to the passage of liquid." *See* Appendix A at 4a. The combination provides a mechanism "which reduces spillage *beyond that of either mechanism alone.*" *See* Appendix A at 4a (emphasis added).

The Federal Circuit quoted the patentee's argument as follows:

> Thus two separate mechanisms are both used to close off the passage of liquid through the valve when not in use. The first mechanism involves an inverting, *flexible valve material which has a slit* therein and responds to suction. The second mechanism involves the use of a blocking element, which is impenetrable to the passage of liquid. The slit sits against the blocking element, sealing or blocking off the slit, to yet further prevent the passage of liquid through the valve.
>
> . . . . By providing *both the elastomeric member with a slit and a blocking element,* a sealing mechanism is provided which reduces spillage beyond that of either mechanism alone. None of the references cited in the Office Action [Robbins III, Bachman, and Belcastro] teach or suggest such

> *a no-spill mechanism having a slit sitting against a blocking element such as is recited in all of the pending claims.*
>
> '931 Application Response, Oct. 2, 2000 (emphases added).
>
> Thus during prosecution the presence of the slit in the flexible valve material was emphasized as distinguishing *all* of the claims from the cited references.

See Appendix A at 4a (emphasis added).

The Petition implies that the claims that were the subject of the patentee's prosecution arguments were only claims that recited "slit" and that when those claims were later amended to "remove" the term "slit" in favor of "opening," the earlier prosecution arguments were rescinded. But, that is not what happened.

At the time of the patentee's arguments, thirteen of the nineteen claims pending in the '931 patent application recited "opening." Only six claims recited "slit." *See* A0222-A0226. And, as the Federal Circuit noted, the patentee expressly represented that his argument applied to "all" the claims pending at the time. *See* Appendix A at 4a. That included claims that recited "opening" rather than "slit." *See* A0222-A0230. The patentee's argument defined the scope of his invention as requiring an opening that operates as a "slit." The patentee thus disclaimed a construction in which "opening" means any type of hole or opening whatsoever, as Petitioner now argues.

Petitioner cites *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211 (1940) for the proposition that a limitation may not be read back into the claims after it was expressly removed during prosecution. *See* Petition at 15. But, that is not at all what happened here. Here, the patentee applied his arguments regarding the necessary characteristics of a "slit" to his invention's two separate sealing mechanisms to distinguish claims that recited "opening," as well as claims that recited "slit." The patentee's representation to the PTO that his arguments applied to "all" his claims, even those that recited "opening," characterized his invention as a whole. Indeed, without a slit-like opening, the required two separate sealing mechanisms — that the patentee argued distinguished over the prior art — would not exist.

Petitioner's argument now that by amending some allowed claims to recite an "opening" rather than a "slit" he effectively rescinded his prosecution disclaimer and broadened his claim scope such that the term "opening" means any type of hole or orifice does not comport with reality.

Petitioner stretches the facts when he suggests that he rescinded his previous arguments because he told the PTO he was broadening his claims. *See* Petition at 20. In fact, the Petitioner downplayed the significance of his amendments referring to them as "minor" and "slight"; and, he expressly reaffirmed his previous arguments for patentability. Specifically, the patentee stated:

> In the Notice of Allowance dated December 22, 2000, all of the claims in this application were found to present patentable subject matter. In the present CPA, Applicant is entering *minor* changes

> to Claims 1-2 to claim "an opening" as opposed to "a slit", and to recite "a slit" in dependent claims thereto. This change *slightly* broadens the scope of the first two claims. However, both claims still present patentable subject matter; *the other independent claims of the application previously recited an opening, and all of those claims were deemed to be patentable.*

See A0264 (emphasis added).

Seen in the full context of his prosecution remarks, the Petitioner's assertion that the later amendment of some claims to recite "opening" was a rescission of the patentee's earlier patentability argument is fiction. The patentee's representation to the PTO that the later amendment "slightly broadens" the claim scope clearly refers to the fact that the term "opening" encompasses other slit-like openings such as the "T-shaped" and "Xshaped" "openings" disclosed in the patent specification (*see* A0193, col. 8, lines 62-65), which operated in the same way as a slit but technically were not a single cut in the flexible material. The "minor changes" to "slightly broaden" some claims certainly did *not* signal a wholesale reversal of the narrowed meaning of "opening" that the patentee emphatically relied on to overcome the Examiner's prior art rejections.

Petitioner's suggestion that the doctrine of "claim differentiation" precludes the claim construction found by the Federal Circuit and district court is wrong. First, "claim differentiation" does *not* apply here at all. There are *no* different claims that are being interpreted such that they are identical in scope. As both the Federal Circuit and district court held, the independent claims that recite "opening" must

be construed to be slit-like so as to provide the necessary two sealing mechanisms that the patentee represented to the PTO was the basis for distinguishing his invention over the prior art. *See* Appendix A at 8a-9a. As such, "opening" can comprise a slit as well as the T-shaped and X-shaped "openings" that, like a slit, are normally closed to block fluid but which, upon the application of suction, stretch open to allow fluid to pass. The dependent claims that recite "slit" specify one particular "opening" among the various possibilities of "slit," "X shape" and "T shape" that are generally encompassed by the independent claim. There is no identity of scope between claims reciting "opening" and those specifying "slit."

In any event, it is well settled that the doctrine of claim differentiation is merely a guideline that is trumped by prosecution disclaimer. *Seachange Int'l., Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005) (holding that the doctrine of claim differentiation is not a hard and fast rule and will be overcome by a contrary construction dictated by the written description or prosecution history).

Petitioner's argument that the Federal Circuit's decision has created a new rule of law that threatens to evaporate untold patents directed to pioneering inventions is absurd, bears no relation to the facts of this case and is nothing more than a scare tactic to obtain a rehearing where there is no basis for one.

Notwithstanding Petitioner's hyperbole, the simple facts here are that to distinguish his invention over the prior art, the patentee repeatedly and unequivocally defined his invention and claim scope in the same way with respect to claims that recited "opening" as well as claims that recited

"slit." When the patentee later removed the term "slit" from some of the allowed claims, he represented to the Examiner that the amended claims were allowable for the same reasons he had earlier argued in connection with claims reciting "opening." He in no way broadened the limited meaning of "opening" that he had earlier urged to successfully obtain claim allowance.

In finding a prosecution disclaimer, the Federal Circuit relied on well-established precedent of this Court that expressly holds that a patentee cannot argue that his invention is one thing during prosecution and then some broader thing in litigation. *See* Appendix A at 8a (citing *Omega Eng'g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1324 (Fed. Cir. 2003) ("The doctrine of prosecution disclaimer is well-established in Supreme Court precedent, precluding patentees from recapturing through claim interpretation specific meanings disclaimed during prosecution."); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 220-21 (1940); *Crawford v. Heysinger*, 123 U.S. 589, 602-04 (1887); *Goodyear Dental Vulcanite Co. v. Davis*, 102 U.S. 222, 227 (1880)).

The Federal Circuit did *not* proclaim a "new rule of prosecution disclaimer" but rather followed the over one hundred year old precedent of this Court in construing the relevant patent claims.

2. The Federal Circuit's Claim Construction Is Consistent With This Court's Precedent

While petitioner complains broadly about how the Federal Circuit supposedly mishandles the issue of claim construction on a regular basis, he totally fails to present any compelling reason why the Federal Circuit's handling of claim construction *in this case* was wrong.

As discussed above, the Federal Circuit did not adopt a new rule of prosecution disclaimer. Rather, the Federal Circuit followed the well established precedent of this Court. *See* Appendix A at 8a. And, contrary to Petitioner's assertions, the doctrine of prosecution disclaimer that the Federal Circuit follows is fair to both patentee and the public.

> The public notice function of a patent and its prosecution history requires that a patentee be held to what he declares during prosecution of his patent. A patentee may not state during prosecution that the claims do not cover a particular device and then change position and later sue a party who makes that same device for infringement.

Spring Window Fashions L.P. v. Novo Indus., L.P., 323 F.3d 989, 995 (Fed. Cir. 2003).

As for the '620 patent, Petitioner complains that Federal Circuit and district court failed to do the proper claim construction analysis. But in fact, the courts below *did* construe all of the claim terms in dispute — "closed position" and "begins to invert" — and provided eminently reasonable bases for the construction. *See* Appendix A at 8a at 12a-14a.

Petitioner's complaint that the district court refused to hold a Markman Hearing or to take any testimony (*see* Petition at 10) should be rejected out of hand. There is *no* requirement that a court conduct a separate "Markman Hearing." *See Ballard Med. Prods. v. Allegiance Healthcare Corp.*, 268 F.3d 1352, 1358 (Fed. Cir. 2001). Indeed, it is common for the courts to perform claim construction in the context of summary judgment motions just as the district court did below. *See id.*

There also is no requirement that a court take testimony in the process of claim construction. It is well settled that it is the intrinsic evidence—the patent claims, specification and prosecution history—is of paramount importance in a claim construction analysis. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1315-1317 (Fed. Cir. 2005). While, after the fact testimony and other like "extrinsic" evidence may be used, it is *not* a requirement and, if used, can only be used to understand the court's understanding of the technology. *See EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 892 (Fed. Cir. 1998).

Moreover, the only "evidence" that Petitioner asserts the Federal Circuit improperly failed to consider in its claim construction analysis was Petitioner's own self-serving, conclusory "expert" declaration that he submitted late, after the close of expert discovery. The district court properly excluded that so-called "evidence" and the Federal Circuit properly affirmed the district court's discretionary ruling to exclude. The Federal Circuit noted that Petitioner:

> . . . failed to provide a timely expert report or to submit himself for deposition, that expert testimony is not needed by the Court in this case, and that Hakim's testimony is self-serving, biased and of no assistance to the Court in understanding the 'technology' involved regarding the simple device at issue in this case.

See Appendix A at 14a-15a. The Federal Circuit further properly held:

> This discretionary ruling is not grounds for reversal, for we have not been shown how the trier

> of fact was led into error, or could reasonably have reached a different decision had the inventor's declaration been admitted. This evidentiary ruling was in accordance with the Rules, and is affirmed.

See Appendix A at 15a. There is no compelling reason for this Court to revisit the issue.

CONCLUSION

In the final analysis, Petitioner's broad sweeping assertions of error below are meritless. Petitioner has totally failed to demonstrate any compelling reason to grant a Petition for a Writ of Certiorari in this case.

It is respectfully submitted that the petitioner should be denied.

Accordingly, there is no compelling reason to grant certiorari here.

Respectfully submitted,

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Dated: September 7, 2007

(3)

No. 07-150

FILED
SEP 18 2007
OFFICE OF THE CLERK
SUPREME COURT, U.S.

IN THE

Supreme Court of the United States

NOURI E. HAKIM,

Petitioner,

v.

CANNON AVENT GROUP, PLC, CANNON RUBBER LIMITED AND AVENT AMERICA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

REPLY BRIEF

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CORPORATE DISCLOSURE STATEMENT

Petitioner's Corporate Disclosure Statement was set forth at page *ii* of its Petition for a Writ of Certiorari, and there are no amendments to that Statement.

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SUMMARY OF ARGUMENT

The present case concerns the principles of claim construction required by this Court's precedent. In patent law, no question is more important – claim construction affects the litigation of every patent in the United States. Currently, however, claim construction at the Court of Appeals is thoroughly unpredictable and is not constrained by a coherent or uniform view of this Court's precedents.

Respondents confirm this by failing to address any of the claim construction principles of this Court cited in Petitioner's brief. Respondents provide no real support in the record that any of those construction principles – at all – were followed, or even addressed, for the invert limitation.

Likewise, for the opening limitation, Respondents' attempt to justify the Court of Appeals' newest rule of prosecution disclaimer is an empty one. Respondents set forth a fanciful perspective as to the prosecution of Hakim's patents, which recasting is intended to demonstrate that a hole is not an opening. Their spin, however, did not address any of this Court's legal principles of construction cited in Petitioner's brief, the principles actually applied by the Patent Office during prosecution of the patent, or the applicable statutory and regulatory provisions.

By their silence on the relevant legal issues, Respondents only confirm the Court of Appeals' failure to adhere to the claim construction principles required by this Court's caselaw. That failure increases the unpredictability of patent litigation. It further leads to generally absurd results, and can only be corrected by issuance of guidance regarding the hierarchy of principles required in the interpretation of patent claims, as rooted in a systematic view of this Court's long-standing precedent.

ARGUMENT

I. Petitioner's Argument That the Court of Appeals Has Not Followed the Claim Construction Principles of this Court Stands Unrebutted

The issue of claim construction is not only compelling, it is currently the most important topic in modern patent jurisprudence. Claim construction is an essential threshold step in every single case of patent infringement and invalidity litigated in the United States. The lack of any predictability in claim construction affects not just some, but all issued patents, and affects every industry that relies upon patent protection to protect its innovations from piracy and illegal copying.

Petitioner's brief outlined the various evidentiary underpinnings required by this Court's precedent as part of the claim construction process. It also demonstrated that the Court of Appeals follows no systematic, uniform approach to claim construction that would yield predictable results. Respondents' brief only confirms this.

For example, Respondents were not able to reference any real analysis of the "invert" limitation in the lower court decisions. There was no construction of that crucial term with reference to the specification, the contrast with other claims (which lack the invert limitation), the prior art, or anything else.

Indeed, Respondents' self-serving argument that the only evidence regarding this limitation was in an expert declaration is transparently wrong. The specification of the patent itself shows the invert limitation, as illustrated, for example, in the color-coded figures appended to Petitioner's brief. *See,* App. 70a. Likewise, under the doctrine of claim differentiation, the differences between the claims themselves also show the importance of the invert requirement, as some claims recite it

and others do not. *See e.g.*, '931 patent claim 10 (App. 62a) vs. claim 8 (App. 62a).

Claim construction is an essential first step in any patent case — the meaning of the claims *must* be ascertained to determine if they are valid or infringed. *See e.g., Markman v. Westview Instruments, Inc.*, 517 U.S. 370, 374 (1996). But here, claims with the invert limitation were all invalidated without any thoughtful discussion of what the limitation even means or whether it was or was not in the prior art.

Indeed, Respondents have not pointed to any meaningful judicial analysis of the invert term in any form at all. Rather, the district court opined that the exact term used in the claims doesn't matter(!) (App. 30a) and the Court of Appeals upheld. A worse summary of the demands of over a hundred and fifty years of this Court's claim construction jurisprudence is not even possible.

The lack of adherence to this Court's principles likewise holds true for the "opening" and "slit" limitations. This Court has mandated that each claim of a patent must be analyzed in light of the other claims. If a term is set forth in one claim but omitted from another, the claim with the omission may not be limited as if the term were there. *See, Smith v. Snow*, 294 U.S. 1, 13-14 (1935); *See also,* Petition at 5, 16 (discussing this principle, which is also known as the doctrine of claim differentiation).

Respondents do not reference any language in the Court of Appeals' decision that conducted such a differential analysis, or that even addresses this principle with respect to the "opening" and "slit" terms. Rather, they claim it "well settled" that the doctrine of claim differentiation is "merely a guideline" that is trumped by prosecution disclaimer, citing the Federal Circuit's decision in *Seachange*. Respondents' Brief at 12, citing *Seachange, Int'l, Inc. v. C-COR, Inc.*, 413 F.3d 1361, 1369 (Fed. Cir. 2005).

The claim construction requirements of this Court, however, are not mere "guidelines" that are "trumped" by Federal Circuit rules to the contrary. In *Smith*, this Court ruled that an obviously intended contrast in the words of different claims points to a difference in purpose and meaning. *Smith*, 294 U.S. at 13-14. In *Festo*, this Court likewise ruled that amendment of the claims itself emphasizes the difference between the older and newer versions. *See, Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 535 U.S. 722, 736 (2002). The Court of Appeals is not free to disregard binding precedent of this Court, no matter how "well settled" its error.

Furthermore, Respondents' brief presents a very fanciful and confusing approach to the facts of this case and the prosecution history in an attempt to completely sidestep the actual legal issues here. Their approach avoids all of the construction principles and evidentiary requirements of this Court's precedent so as to support a construction that a hole isn't an opening. But even if there were such an alternate and illogical construction, it is irrelevant. As this Court held in *Smith*, if a claim is susceptible of two constructions, the broader one must be adopted, not a fatal, narrow one.[1] Moreover, under *Smith*, claim differentiation trumps allegations of prosecution disclaimer, not the other way around.[2]

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1. *See, Smith*, 294 U.S. at 14 ("If the matter were doubtful, it is plain from what has been said that the character of the patent and its commercial and practical success are such as to entitle the inventor to broad claims and to a liberal construction of those which he has made. In such circumstances, if the claim were fairly susceptible of two constructions, that should be adopted which will secure to the patentee his actual invention, rather than to adopt a construction fatal to the grant") (internal cites omitted).

2. *See e.g., Smith*, 294 U.S. at 16 ("It is of no moment that in the course of the proceedings in the Patent Office the rejection of narrow claims was followed by the allowance of the broader Claim 1"). Here, the Patent Office initially rejected narrow claims to a slit and other (Cont'd)

Again, however, the Court of Appeals gave no weight to that precedent. In fact, Respondents' confused discussion is meant to distract from the complete absence in their brief of any reliance on, or response to, the controlling claim construction principles of this Court cited by Petitioner.

As a further example, this Court has established that the claims of a patent *must* be interpreted in light of the patent's specification. *See e.g.*, Petition at 5, 17-18. Hakim showed that his construction and reading of the prosecution history was completely consistent with the specification definition, which states that an opening includes a hole.

There too, Respondents failed to provide any reference that the Court of Appeals even addressed the specification definition, because the court did not.[3] That principle is another sidestepped by Respondents in their brief. Respondents are glaringly silent

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(Cont'd)
claims reciting an opening. In response, the patentee filed remarks regarding the benefits of a slit, which was followed by allowance of the application by the Patent Office. The patentee then abandoned that application, choosing not to have it issued as a patent. Instead, he filed a continuation in which the he stated that he wanted all of the claims to recite an opening, and that an opening is broader than a slit (and therefore by implication not limited to a slit). The Patent Office then allowed the broader claims. That latter allowance after the patentee's statement demonstrates that the Patent Office was not relying on the earlier remarks regarding a slit to allow the claims. Under *Smith*, the fact that arguments were made regarding the benefits of a slit at a time when numerous narrow claims of the patent recited one has no bearing on the allowance of the subsequent broader claims – claims which were specifically broadened to remove the slit limitation from all of them.

3. There is likewise a complete absence of any reference to where any of the evidentiary underpinnings required by this Court, whether the specification, claim differentiation, or plain meaning, are analyzed or even addressed in the Court of Appeals' decision, because none of those requirements were addressed.

on the issue of the specification because the Court of Appeals gave that mandatory principle of this Court absolutely no weight.

In fact, the prosecution history is entirely consistent with the specification.[4] The failure to rely upon the specification allows fundamental inconsistency within a single integrated written instrument, such that the patent specification and claims unnecessarily contradict each other. Here, for example, it improperly limits the term opening to a slit, when the specification reads to the contrary, and the prosecution history states that the claims were explicitly broadened so that they would not be limited to a slit.[5]

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4. In the full context of the prosecution history, it is clear that the Patent Office allowed the claims both before and after they amended, whether or not they contained a slit, because the early remarks regarding the slit were unnecessary for patentability. The slit, and the earlier remarks regarding it, were unnecessary in the Patent Office's view since no prior art showed a no-spill cup with a blocking element. The blocking element was a characteristic of each and every claim that the Patent Office ever allowed. In contrast, claims were allowed regardless of whether or not they recited a slit therein. The Court of Appeals, however, completely missed this distinction because it did not conduct the analysis of the prior art required by this Court, which would have further demonstrated that a narrow reading of the claims was unnecessary and unwarranted. *See e.g., Smith*, 294 U.S. at 16. Nothing in the Court of Appeals' decision shows any basis in the prior art itself requiring that the claims of Hakim's patent be limited to a slit, or cites any specific evidence that the prior art teaches no-spill cups with a membrane that inverts.

5. "Applicant is entering minor changes to Claims 1-2 to claim "an opening" as opposed to "a slit", and to recite "a slit" in dependent claims thereto. This change slightly *broadens* the scope of the first two claims. However, both claims still present patentable subject matter; the other independent claims previously recited an opening and all of those claims were deemed to be patentable." *See*, A0264 (emphasis added). As discussed above in fn. 4, the claims were expressly broadened and were repeatedly allowed by the Patent Office regardless of whether or not they contained a slit, demonstrating that the slit limitation, and remarks relating thereto, were never deemed necessary for patentability.

In short, Respondents' brief demonstrates that the Court of Appeals did not give the critical evidentiary underpinnings of this Court's precedent any weight. Nor have Respondents addressed the principles applied by the Patent Office during examination, or the applicable statutory and regulatory provisions. Those principles and provisions are consistent with this Court's precedent but are totally inconsistent with the Court of Appeals' decision, which is silent about them. *See e.g.*, Petition at 18.

Furthermore, while Respondents dispute that the rule of prosecution disclaimer established is a new one, the cases they cite do not support their position. Respondent has cited no precedent of this Court requiring that a patentee who *removes* a limitation should nonetheless have the claims limited to the prior remarks regarding that limitation. Yet that is exactly the outcome of the Federal Circuit's decision – it now retroactively requires that an express disclaimer of prior arguments regarding a claim limitation need have been entered in previously issued patents, even if the limitation was deleted from the claim.

As Petitioner pointed out, this new rule is contrary to the principle in *Festo* that amendment of the claims is itself an emphasis of the difference between the old and new versions of the claim (Pet. at 21). The precedent in *Festo* is also not addressed by Respondent. *Festo,* 535 U.S. at 736 (2002).

Moreover, Respondent's position plainly conflicts with common sense. A patentee's express removal of a limitation from a claim (such as the "slit"), is totally inconsistent with any intent to be limited to the scope of prior remarks regarding the benefits of that limitation ("the slit").

It is extremely common for limitations to be removed by amendment during prosecution of patent applications or continuations thereof. Consequently, the Federal's Circuit's latest rule completely undermines the value of all of the patents prosecuted and issued at a time when no such rule was in effect.[6] Moreover, the Court of Appeals has shown its willingness to apply this new rule even when the results it generates are contrary to those produced by the established claim construction principles of this Court.

Indeed, as Petitioner has explained – and as Respondents have also not rebutted – it is relatively rare for the Federal Circuit to view any claim construction issues through the lens of this Court's precedent. Simply stated, the Court of Appeals follows no coherent, uniform, binding framework providing *predictable* guidance as to the ultimate interpretation of terms in patent claims. This underscores the importance of explicit direction from this Court as to the overriding principles that must be followed in claim construction.

The need for a modern ruling by this Court on the hierarchy that must be followed within the established rules of construction is essential, so that claim construction is predictable both in general and when competing principles produce different results. This case directly illustrates the interplay of all of the relevant principles of construction and their associated evidentiary underpinnings, or lack thereof. It is, therefore, a very apt vehicle for such a ruling, providing guidance for future cases. Without such guidance by this Court, the illogical and unjust morass that is the current state of claim construction will only continue.

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6. In fact, the Court of Appeals' rule is contrary to its own precedent that was in effect when the claims were prosecuted (Pet. at 21).

CONCLUSION

As a result, for the foregoing reasons and those previously stated in Petitioner's initial brief, it is respectfully submitted that the petition for *certiorari* should be granted.

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